In the Supreme Court of the United States.

AUTOMATIC SWITCH COMPANY OF BALTIMORE CITY, vs. CUTLER-HAMMER MFG. COMPANY.	In Equity.

Motion For Leave to File Annexed Petition.

And now comes the above-named Automatic Switch Company of Baltimore City, by Philip Mauro, Esq., its counsel, and makes application to this Honorable Court for leave to file its annexed Petition praying for the Writ of Mandamus, or of Certiorari, or both writs ; and further requests that an order to show cause may be granted, directed to the United States Circuit Court of Appeals for the Second Circuit, requiring said Court, or the Judges thereof, to show cause why the Writ of Mandamus should not be granted as prayed in said Petition.

There is a single question of law involved, relating to the right of appeal, which has been decided in favor of that right by the U. S. Circuit Court of Appeals for the Seventh Circuit, while the said Court of Appeals for the Second Circuit has refused that right in the present cause.

New York City, Jan. 8, 1906.

AUTOMATIC SWITCH COMPANY OF BALTIMORE CITY.

By

PHILIP MAURO,

Of Counsel.

IN THE SUPREME COURT OF THE UNITED STATES.

AUTOMATIC SWITCH COMPANY OF BALTIMORE CITY, Complainant-Appellee and Cross-Appellant and Petitioner, vs. CUTLER-HAMMER MFG. COMPANY, Defendant-Appellant and Cross-Appellee.	In Equity.

Petition.

TO THE HONORABLE THE SUPREME COURT OF THE UNITED STATES:

Your Petitioner, the Automatic Switch Company of Baltimore City, a corporation of the State of Maryland, having its principal office and place of business in the City and State of New York, respectfully showeth:

I.

1. Your Petitioner is the owner of the entire right, title and interest in and to U. S. Letters-patent No. 499,769, granted to George H. Whittingham on June 20, 1893, for an Automatic Switch or Regulator for Electric Motors. Heretofore your Petitioner brought its suit in equity in the Circuit Court of the United States for the Southern District of New York against the Cutler-Hammer Mfg. Company, complaining of infringement of the said U. S. Letters-patent by the said defendant. The case duly coming on to be heard, an opinion was filed by his Honor WILLIAM K. TOWNSEND, United States Circuit Judge (reported in 139 Fed. Rep. 870), sustaining the validity of Claims 4, 5, 6, 7 and 8 of the said patent, all the claims sued on, and holding Claims 4 and 5 infringed but the other three claims *not* infringed; and thereupon, on

April 20, 1905, an Interlocutory Decree was entered by the said Court awarding an injunction and accounting in favor of your Petitioner and against said defendant upon Claims 4 and 5 aforesaid, and adjudging that Claims 6, 7 and 8 were not infringed (but not dismissing the bill as to those three claims), and granting your Petitioner one-half its costs; and at the same time an Order of Suspension was entered by the said Court suspending the operation of said injunction pending an appeal to the United States Circuit Court of Appeals for the Second Circuit. Copies of the said Whittingham patent, of the said Opinion, of the said Interlocutory Decree granting the injunction, and of the said Order suspending the injunction, are ready to be produced as part of this Petition.

2. Thereafter, on May 12, 1905, the said defendant took its appeal from the said Interlocutory Decree to the U. S. Circuit Court of Appeals for the Second Circuit, and on the same day the citation was signed by the Honorable E. HENRY LACOMBE, United States Circuit Judge, and the Circuit Court lost jurisdiction of every matter in controversy—except as to Claims 6, 7 and 8, as to which matters alone that Court still retained its jurisdiction; and thereupon the entire record was duly certified up to the said Court of Appeals.

3. That on May 26, 1905, there was signed and entered in the said Circuit Court a "Final Decree as to Claims 6, 7 and 8," disposing finally of all matters then remaining before that Court, by dismissing the Bill of Complaint as to those three Claims of the said Whittingham patent; whereupon, on June 7, 1905, complainant (acquiescing in the dismissal as to Claim 8) took its appeal from the said Final Decree as to Claims 6 and 7 of the said Whittingham patent, to the said U. S. Circuit Court of Appeals for the Second Circuit, and the citation was signed by the Honorable E. HENRY LACOMBE aforesaid on the same day. Copies of the said Final Decree as to Claims 6, 7 and 8, of the said Appeal therefrom, and of the Assignments of Error in support thereof, are ready to be produced as part of this Petition.

4. Thereafter, by agreement between the parties, each party, for the purpose of said appeals, supplied sufficient

printed copies of its own record in the Court below and paid in advance one-half of the costs for perfecting the appeal, as estimated by the Clerk of the said Court of Appeals.

5. Thereafter, and after said printed copies had been furnished by your Petitioner, and the money for the said one-half of the estimated costs had been paid by your Petitioner, the said defendant-appellant and cross-appellee, the Cutler-Hammer Mfg. Company, moved to dismiss your Petitioner's said appeal upon the ground that the said Court of Appeals had no jurisdiction to entertain the same, and said defendant gave notice that it would claim a *Preference;* after due deliberation, the said Court of Appeals on December 21, 1905, indicated its decision by the words "*Motion granted*", but without assigning any reason or giving any written or oral opinion; and in pursuance thereof, on January 3, 1906, an Order was entered dismissing your Petitioner's said appeal. A copy of the said Motion to dismiss the appeal is ready to be produced as a part of this Petition; and a certified copy of said Order of Dismissal is annexed hereto.

II.

6. Your Petitioner shows that there is a single question of law here involved, to wit: "Where, in a patent suit in equity, after final hearing upon pleadings, proofs, and exhibits, there has been a decision upon the merits, and an *interlocutory* decree granting an injunction as to certain Claims of the patent in suit, and defendant has taken its appeal from said interlocutory decree and has already carried up the *entire record* to the Court of Appeals; and where there is a *subsequent* FINAL DECREE dismissing the bill as to other claims of the same patent; has the Court of Appeals jurisdiction to entertain an appeal from that subsequent decree?

This question has been decided affirmatively, in favor of the jurisdiction of the Courts of Appeals to entertain such cross-appeals, by the U. S. Circuit Court of Appeals for the Seventh Circuit in *Chicago Wooden Ware Co. vs. Miller Ladder Co.*, 133 F. R. 541, 544-5, relying upon the decision of this Court in *Smith vs. Vulcan*, 165 U. S., 518. And a similar result has been reached by the United States Circuit Court of

Appeals of the Fourth Circuit in *Scriven vs. North*, 134 F. R., 366, 368-9.

Whereas, it has been decided in the negative in the present case, the U. S. Circuit Court of Appeals for the Second Circuit having refused to entertain jurisdiction.

7. Your Petitioner shows that the term of its patent is running out, and in the meantime the defendant is not under injunction and is infringing extensively; and that your Petitioner will be irreparably injured by delay and will be grievously and irreparably injured if it be not allowed to prosecute its said appeal as to Claims 6 and 7 and argue the same at the same time with defendant's appeal as to Claims 4 and 5. Among other reasons why your Petitioner would be injured by having to argue the cause *piecemeal* before the said Court of Appeals, your Petitioner shows the following:

(a) Should the Court of Appeals *affirm* the decision of the Circuit Court, the parties would have to proceed with the accounting; and thereafter your Petitioner would have to renew its appeal as to Claims 6 and 7, or forego all rights thereunder as against this defendant,—thus necessitating a *second appeal*, and *a second consideration* by the Court of Appeals of all matters here involved.

(b) Furthermore, should this second appeal be *sustained* in your Petitioner's favor, there would have to be a *second accounting*, which might or might not proceed upon a different theory from that employed in the first accounting, which would then be followed by a *third appeal*. (See *Scriven vs. North*, 134 F. R., 366.)

(c) Should the Court of Appeals *reverse* the Circuit Court and order the bill dismissed as to Claims 4 and 5, your Petitioner would then have to renew its appeal as to claims 6 and 7, and present the same (and additional) matters *a second time* before the Court of Appeals, which might be followed by an accounting and then a *third appeal*.

(d) Your Petitioner fears, and has reason to fear, in view of the decision of this Court in *Hill vs. Chicago R. R. Co.*, 140 U. S., 52, that if it should hereafter renew its appeal from the dismissal as to Claims 6 and 7, entered on May 26, 1905, the Court of Appeals will hold such appeal too late, not having been taken within six months from the said date,—

so that your Petitioner would be altogether without remedy in the premises.

(e) Your Petitioner further shows that the Claims involved in its appeal (Claims 6 and 7), and the Claims involved in defendant's appeal (Claims 4 and 5) are so closely related that consideration of either group requires and demands consideration of the other group of Claims and comparison of the two groups; and your Petitioner fears, and has reason to fear, that the Judges who would hear and decide any renewed appeal by your Petitioner as to Claims 6 and 7, might feel themselves precluded by the language employed by the Judges who shall have decided the defendant's appeal as to Claims 4 and 5, even though the last-named Judges had not intended any such effect to be given to their decision.

WHEREFORE, and for the reason that unless this Court commands the United States Circuit Court of Appeals for the Second Circuit to receive and entertain your Petitioner's said appeal, your Petitioner will be utterly without remedy in the premises, your Petitioner respectfully prays that a Writ of MANDAMUS may be granted out of and under the seal of this Honorable Court directed to the United States Circuit Court of Appeals for the Second Circuit, commanding that Honorable Court to receive and entertain your Petitioner's said appeal; or in the alternative that a Writ of CERTIORARI may be granted in like manner, directing the said Honorable Court of Appeals to certify to this Court, for determination by this Court, the question of law set forth in paragraph 6 of this Petition, together with such papers and proceedings relating thereto as may be necessary for the proper consideration and determination of said question; or that both of said writs may be granted; and your Petitioner likewise prays for such other and further relief as the case may require.

And your Petitioner will ever pray.

Dated New York City, January 8th, 1906.

AUTOMATIC SWITCH COMPANY OF BALTIMORE CITY.
by C. A. L. MASSIE
of Counsel.

PHILIP MAURO,
C. A. L. MASSIE,
Of Counsel for Petitioner.

STATE OF NEW YORK, }
County of New York, } ss.:

C. A. L. MASSIE, being duly sworn, deposes and says that he is of counsel for the petitioner herein and has had charge of this litigation from its beginning; that he has read the foregoing petition and knows the contents thereof and that the same are true to his own knowledge.

C. A. L. MASSIE.

Subscribed and sworn to before me this 4th day of January, 1906.

RALPH LANE SCOTT,
Notary Public,
New York County.

[SEAL.]

Certified Copy of Order of Dismissal.

IN THE UNITED STATES CIRCUIT COURT OF APPEALS

FOR THE SECOND CIRCUIT.

Present: HONS. W. J. WALLACE, E. H. LACOMBE, and A. C. COXE, United States Circuit Judges.

AUTOMATIC SWITCH COMPANY OF BALTIMORE CITY, Complainant-Appellee and Cross-Appellant, vs. THE CUTLER-HAMMER MFG. CO., Defendant-Appellant and Cross-Appellee.	In Equity, Calendar No. 118.

This cause coming on to be heard upon motion by the said Cutler-Hammer Mfg. Company to dismiss the cross-appeal of

the said Automatic Switch Company of Baltimore City, upon the ground that this Court has no jurisdiction to entertain the said cross-appeal; and W. Clyde Jones, Esq., being heard for the motion, and C. A. L. Massie, Esq., being heard in opposition, and each party having filed a printed brief; and the Court being duly advised in the premises;

Now, therefore, it is hereby ADJUDGED, ORDERED and DECREED that the said motion be and the same hereby is granted and that the said cross-appeal taken by the said Automatic Switch Company of Baltimore City be and the same hereby is dismissed upon the ground that this Court has no jurisdiction to entertain the same.

Dated, Jan. 3, 1906.

A true copy,
(Signed) WM. PARKIN,
Clerk (SEAL).

(Sgd)
E. H. L.
A. C. C.

Filed Jan. 3, 1906.

IN THE SUPREME COURT OF THE UNITED STATES.

AUTOMATIC SWITCH COMPANY OF BALTIMORE CITY vs. CUTLER-HAMMER MFG. COMPANY.	In Equity.

BRIEF IN SUPPORT OF PETITION.

I. Forms of Procedure.

From the facts stated in the Petition we shall show that the Automatic Switch Company of Baltimore City is entitled to have its appeal entertained by the United States Circuit Court of Appeals for the Second Circuit, as a matter of right; also, that we will be seriously and irreparably injured by the refusal to entertain jurisdiction of the appeal. MANDAMUS is the appropriate remedy to compel allowance of an appeal in a proper case.

Beach Mod. Eq. Pr., Sec. 954, p. 930.
Ins. Co. vs. Comstock, 16 Wall., 258.
Vigo's case, 21 Wall., 648.
Rd. Co. vs. Wiswall, 23 Wall, 507.
Ex parte Jordan, 94 U. S., 248.
Ex parte R. R. Co., 95 U. S., 221.
Ex parte Parker, 120 U. S., 737.
Hollon Parker, 131 U. S., 221.
Matter of Christensen Co., 194 U. S., 458.

See, also,
Ex parte Hohorst, 150 U. S., 653.

Moreover, where one Circuit Court of Appeals has decided a question one way, and another Circuit Court of Appeals has decided a similar question in the contrary manner—the decision in the Second Circuit (here complained of) is contrary to the decision in the Seventh Circuit (Chicago, &c., Co. vs.

Miller, 133 F. R., 541, 544-5) and of the Fourth Circuit (Scriven vs. North, 134 F. R., 366, 368-9)—a situation is presented that calls for *certiorari* in order that the Supreme Court may declare the correct practice, and in order to secure uniformity of decision. See:

Smith vs. Vulcan Iron Works, 165 U. S., 518.
Amer. Construction Co. vs. Jacksonville, &c., Co., 148 U. S., 372.
Forsyth vs. Hammond, 166 U. S., 506.
United States vs. Three Friends, 166 U. S., 1.
In re John Woods, 143 U. S., 202.
Lau Ow Bew, 144 U. S., 47.

II. Our appeal was from a final decree.

Our appeal, which the Circuit Court of Appeals has refused to entertain, was taken from a "*Final Decree.*" The "Interlocutory Decree" of April 20, 1905, divided the claims into two groups, and held Claims 4 and 5 valid and infringed and the other three Claims (6, 7 and 8) also valid but *not* infringed; this Interlocutory Decree sustained the bill as to the first group by awarding an injunction and an accounting, with one-half of the costs, but it *did not dismiss the bill as to Claims 6, 7 and 8.* As to these three Claims, the bill was still undisposed of one way or the other. About three weeks later, on May 12, the defendant appealed from said "Interlocutory Decree," and the appeal was duly allowed. The allowance of the appeal carried to the Circuit Court of Appeals the subject-matter involved and completely ousted the jurisdiction of the Circuit Court *as to such matters.* Therefore, after defendant had appealed, the extent of jurisdiction still retained by the Circuit Court, was only as to Claims 6, 7 and 8. The Circuit Court had jurisdiction as to these Claims, and had no other jurisdiction.

Consequently, when two weeks later, on May 26, we entered a decree disposing of the bill as to Claims 6, 7 and 8, this decree completely and finally disposed of everything then remaining before the Circuit Court. There remained nothing further for the Circuit Court to decide or dispose of. Even the matter

of costs had already been determined under and by virtue of the prior "Interlocutory Decree." Such decree is final.

See Hill vs. Ry. Co., 140 U. S. 52.
Grant vs. E. & W. R. Co., 50 F. R., 795.
Forgay vs. Conrad, 47 U. S., 200.
Potter vs. Beale, 50 F. R., 860.
Scriven vs. North, 134 F. R., 336, 368.
City of New Orleans vs. Peake, 52 F. R., 74.
Beach Mod. Eq. Br., § 913, p. 895.

A text writer puts it :

> "Where a decree dismissed a bill as to all matters except one which was severable from the rest, as to which a subsequent decree was entered, it was held that the right to appeal from the first dismissal began to run from the entry of the first decree" (Foster's Fed. Pr. (2d Ed.), § 483, p. 1038, citing *Hill vs. Ry., supra;* and *Central Trust Co. vs. Locomotive Co.*, 135 U. S., 207).

Paraphrasing this :

> "Where a decree *sustained* a bill as to certain matters [Claims 4 and 5] but not as to certain other matters [Claims 6, 7 and 8] which were severable from the rest, as to which latter a subsequent decree was entered *dismissing the bill*, it must be held that the right to appeal from that dismissal begins to run from the entry of that decree of dismissal."

In *Hill vs. Ry. Co.* (140 U. S., *supra*), a decree was entered directing an accounting as to certain matters as against certain defendants, ordering that the bill be dismissed as to certain other matters and as against certain other defendants, and declaring that upon return of the master's report such further decree would be rendered as might be equitable. This decree was called an *interlocutory* decree. When the accounting was completed a final decree was entered, which besides ordering payment of the amount found by the accounting, etc., again decreed that all other relief prayed for by the complainant be denied (140 U. S., p. 53, line 33). Thereupon, complainant appealed from this so-called "Final Decree" but the Supreme

Court held that the so-called " Interlocutory Decree " was in reality a *final decree* as to the matters ordered dismissed [*e. g.*, in this case, as to Claims 6, 7 and 8] ; and that the appeal was therefore taken too late. Consequently the complainant was remediless.

The case was cited with approval in *Bank vs. Smith*, 156 U. S., 330, 335.

III. Act of 1900.

In the foregoing discussion we have taken the ground that the subject-matter of the " Final Decree " of May 26 was *severable* from the subject-matter of the " Interlocutory Decree " of April 20, 1905. The Opinion of the Court made a distinction between them, the two Decrees themselves made the distinction, and defendant's Appeal has made the distinction. Nevertheless, it may be urged that in reality there is but *one* decree, and that the paper dated May 26 is but an amendment or supplement of the paper of April, and that the two might have been and usually are formulated as one paper. That may be true, but in the present case there *are* two separate decrees—one (as to Claims 4 and 5) " interlocutory," because there yet remains the Master's report before a *final* decree can be entered ; and the other (as to Claims 6, 7 and 8) " *final*," because it disposes completely of the entire subject matter before it.

Therefore, it must follow either that the two papers relate to *severable* matters, or that they constitute different parts of one and the same degree. If the former, then our appeal should be allowed without further discussion, as being from a *final* decree ; if the latter, it remains to discuss the effect to be given to the Act of 1900 relating to *interlocutory* decrees.

The language of this statute is plain and unambiguous : it is as follows :

> " SEC. 7. That where, upon a hearing in equity, in a district court or in a circuit court, or by a judge thereof

in vacation *an injunction shall be granted or continued* or a receiver appointed, *by an interlocutory order or decree*, in a cause in which an appeal from a final decree may be taken under the provisions of this Act to the Circuit Court of Appeals, *an appeal may be taken from such interlocutory order or decree granting or continuing such injunction*, or appointing such receiver to the Circuit Court of Appeals: Provided, that the appeal must be taken within thirty days from the entry of such order or decree, and it shall take precedence in the Appellate Court; and the proceedings in other respects in the court below shall not be stayed, unless otherwise ordered by that court, or by the appellate court or a judge thereof, during the pendency of such appeal: Provided further, that the court below may in its discretion require as a condition of the appeal, an additional bond."

The present cause, being a patent suit, is one "in which an appeal from a Final Decree may be taken * * * to the Circuit Court of Appeals," therefore it comes within the provisions of amended Section 7. Omitting the reference to the *continuing* of an injunction or the appointment of a *receiver* (with which we are not here concerned), and omitting the reference to an interlocutory *order* (as distinguished from an interlocutory *decree*), the material provisions of this Act are as follows:

> "SEC. 7. That where * * * an injunction shall be granted * * * by an interlocutory decree * * * *an appeal may be taken* from such interlocutory decree * * * to the Circuit Court of Appeals. * * *"

There is no question that the "Decree" here in question—made up of the two portions entered in April and May respectively—is "an interlocutory decree granting an injunction;" therefore, there can be no question but that "*an appeal may be taken* from such interlocutory decree." The language is so unambiguous that any construing thereof is superfluous and uncalled for. Nevertheless, this Court in

Smith vs. Vulcan Iron Works (165 U. S., 518) felt called on to say that this Act

> " authorizes, according to its grammatical construction and *natural meaning*, an appeal to be taken from the *whole* of such interlocutory order or decree, and not *from that part of it only which grants or continues an injunction.*"

The Court continues:

> " The manifest intent of this provision * * * appears to this Court to have been * * * also to save both parties from the expense of further litigation * * *."

Accordingly, if we assume that the paper of April and that of May amount to a single " interlocutory decree," then (when an appeal has been taken) the Court of Appeals is authorized by the Statute, " according to its grammatical construction and natural meaning," to consider " the *whole* of such interlocutory decree, and not (from) *that part of it only which grants or continues an injunction.*" [On the other hand, if the two Decrees are distinct and severable, then the Decree of May is *final*, and therefore appealable at once.]

This view of the decision in *Smith vs. Vulcan Works* is taken by the Court of Appeals in the Seventh Circuit (rendered May 12, 1904), which we believe is the latest decision on this precise question.

> *Chicago Wooden Ware Co. vs. Miller Ladder Co.*, 133 F. R., 541, 544-5.

The same result was reached by the Court of Appeals for the Fourth Circuit, in an even later decision, rendered November 15, 1904, in

> *Scriven vs. North*, 134 F. R., 366, 368-9.

Even in the First Circuit it has been held that when the " *full record* " is brought before the Court of Appeals, the Court " may go *fully into the merits.*"

> *Marden vs. Campbell Mfg. Co.*, 67 F. R., 809 (5th syllabus).

It must be noted that Congress did not undertake, by express language, to limit the right of appeal from such interlocutory decree *to the defendant only*. Had this been the intention of Congress, it would have been very easy to express it. Instead of saying "* * * an appeal may be taken *by the defendant* from such interlocutory order or decree, * * *" the Act reads as it does, saying simply, "an *appeal* may be taken,"—leaving open to whoever is aggrieved by such decree (be he complainant or defendant) to take "an appeal."

The argument has been made that the history of the various amendments to the Evarts Act demonstrates that Congress has *intended*, by the Act of 1900, to limit the right of an appeal to the defendant. The argument runs as follows: (1) Under the original Act of 1891, Section 7 grants the right to an appeal from an interlocutory order or decree granting or continuing such injunction. Following this Act came numerous decisions denying *complainant's* right to a cross-appeal where the decree was partly in his favor and partly against him; thereafter came the amendment of 1895, enlarging the right of appeal so as to permit an appeal from an interlocutory order or decree *refusing* the injunction. And (2) that, by the Act of 1900, Congress restored the conditions existing under the original Act of 1891 (except to render the appointment of a receiver appealable); and that, in consequence, Congress intended to sanction the decisions aforesaid, rendered before 1895.

The answers to this argument are plain: First, as a matter of fact, the Act of 1900 purports to amend the Act of *1891*, and ignores the intervening Act of 1895. It is generally believed in the profession and (we believe) on the bench, that the lawmakers overlooked the Act of 1895; in fact, this has been judicially stated in a reported opinion. At any rate, the plain effect of the Act of 1900 is merely to take away the right to appeal from an interlocutory order or decree refusing an injunction (while creating the right to appeal from the appointment of a receiver). This distinction is all that is necessary to support the present Act, and to render the actions of Congress consistent; while to construe the Act of 1900 as going further than this, unnecessarily deprives every complainant of a valuable right. Second, Congress could not have *intended* to

approve the Circuit Court of Appeal's decisions (referred to as rendered before the Act of 1895), because these were not decisions *by the Supreme Court.* The law-makers had a right to assume that an aggrieved complainant cross-appellant could apply to the Supreme Court of the United States for a proper interpretation of the Statute, as in fact was done in the case of *Smith vs. Vulcan,* (165 U. S., *supra*).

Real Purpose and Effect of the Acts.

Before the Evarts Act, no appeal could be taken from an *interlocutory* decree, but an appeal could be taken from any *final* decree; in fact, *both parties* could appeal from a final decree, each appealing from so much thereof as was against him. By the Evarts Act and the various amendments thereto, Congress has undertaken to take certain specific interlocutory decrees out of the class of *non*-appealable decrees and place them in the class of *appealable* decrees. Consequently, if an interlocutory decree come within this class of "appealable decrees," then (for all purposes of taking the appeal) it follows the nature of an *appealable* "final decree," that is, just as each party can appeal from so much of a final decree as is against him, so each party may appeal from so much of an appealable interlocutory decree as may be against him. Now the Act as it stands at present places "*an interlocutory decree that grants an injunction*" within the class of "appealable decrees;" consequently, either party who is aggrieved by it may appeal therefrom.

All interlocutory decrees must fall within one of two classes: 1st, those that grant an injunction, and 2d, those that do *not* grant an injunction (viz., *all other* interlocutory decrees). Where an interlocutory decree grants an injunction as to one claim of a patent and refuses injunction as to another claim, such decree falls within the first class, and is appealable. The fact that *an injunction is granted* is what determines the character of the decree. Therefore we believe that under the plain grammatical meaning of the Act of 1900, where an interlocutory decree *grants an injunction* as to one claim of the patent while refusing it as to another claim, such decree is appealable, and the complainant who is aggrieved by such decree (in

that he has not received complete relief) has the right to appeal from the decree *as a whole* (*Smith vs. Vulcan, supra*).

Nevertheless, the grounds of our present application are much stronger than this, and it is not necessary for this Court to go to the extent just indicated.

Ours is a Cross-Appeal.

In the present case the defendant has already appealed, and has already taken up to the Court of Appeals the *entire record*. The whole subject matter of this litigation is now before that Court. The entire matter must be examined and considered by that Court, and that Court has authority to examine and dispose of *every* question (*Smith vs. Vulcan, supra*).

Even if we concede that a complainant cannot appeal from an interlocutory decree that is partly for him and partly against him, except by way of cross-appeal (where the defendant has *already* taken up the entire record), yet in case of such appeal *by defendant*, reason and analogy, and considerable authority too, demand that complainant's cross-appeal be entertained.

Analogies. Where a court of equity has no equitable ground for jurisdiction, it will refuse to entertain a suit for patent infringement; but where the court had some equitable ground for jurisdiction when the bill was filed, then, although the patent has meantime expired, the court will retain jurisdiction for the purpose of the accounting. Again, where a Federal Court entertains jurisdiction of a controversy by reason of *diversity of citizenship*, it will permit a Bill of Revivor, or the like, between parties who are citizens of the *same* State, upon the ground that it had already acquired jurisdiction of the entire subject matter. In like manner, where one Federal Court has jurisdiction of a suit by reason of *diversity of citizenship*, another Federal Court will entertain proceedings ancillary thereto between citizens of the *same* State, upon the ground that jurisdiction over the main subject matter is in the original Federal Court. Again, under the common law system of pleading, upon demurrer to a *replication*, if the *replication* prove bad, but there is a substantial fault in the *plea* to which it was addressed, judgment will be for the plaintiff, provided the *declaration* be good, but if the *declara-*

tion also be bad, then judgment for the defendant; thus the court will consider the whole matter before it, and not confine itself to the precise question which the parties themselves brought up. Other illustrations might be added to teach this commonsense doctrine—namely, where the court has once obtained jurisdiction of the entire subject-matter—we mean a Court of Equity—it will do *complete* justice to *all* the parties before it; and will decide *all* the questions and matters involved,—even such matters as, if presented alone, would not come within the jurisdiction of the court. So, in the present case, the Court of Appeals has already obtained jurisdiction over the *entire* subject-matter (by virtue of *defendant's* appeal), and should, therefore, decide the *entire* case, and *upon its merits*. The question stated in the *Smith-Vulcan* case was "whether the Circuit Court of Appeals, upon such an appeal, may consider and decide the *merits* of the case." * * * It is inconceivable that the Court of Appeals having the right to "consider and decide the merits of the case" could decide them in defendant's favor if the merits lay with him, yet could not decide the whole matter in complainant's favor, if the merits be with the latter.

"Reasons" Assigned Against Jurisdiction.

The decisions of Courts of Appeals that are cited as holding against the right of cross-appeal under such circumstances, are based upon two propositions: First, the supposed verbal requirements of the statute; and, second, the dread of having to hear an appeal "piece-meal." The *first* ground is untenable in view of the decision of this Court that the "grammatical construction and natural meaning" of the statute permits "an appeal to be taken from the *whole* of such interlocutory order or decree, and not from *that part of it only that grants or continues an injunction.*"

SECOND. Among the leading cases cited against the right of complainant to maintain its cross-appeal under the circumstances here presented, is *Western Electric Co. vs. Williams-Abbott Co.*, 108 F. R., 952 (6th Circuit). The Court below dismissed the bill as to claim 1 but sustained it as to claims 2

and 3; both parties appealing, the defendant's appeal was successful, the Court below being directed to dismiss the bill as to claims 2 and 3, but complainant's appeal was dismissed because prematurely taken. Of course, the next step would be the entry of a decree in the Court below, pursuant to the mandate, dismissing the bill as to all three claims, followed by complainant *then* taking his appeal on claim 1. The Court of Appeals thus invited and forced a *second* appeal. Truly a marvelous way to avoid "piece-meal consideration."

Precisely the same situation is possible here. Let us assume that the Court of Appeals hears argument on *defendant's* appeal, having refused to entertain *our* cross-appeal, and thereafter gives up its time to a careful study of the entire record, resulting (*absit omen*) in sustaining defendant's appeal; thereupon the Circuit Court will be ordered to dismiss the bill as to claims 4 and 5; *after all of which* complainant will finally be permitted to return to the same Court of Appeals with its appeal as to claims 6 and 7, and that Court will then have to re-examine the same record. In other words that Court has the complete record before it *now*, and *one* examination of the record, *one* study of the questions involved, will suffice to pass upon the merits of both appeals; to do otherwise would require the argument by counsel and consideration by the Court of *one* appeal now and of the *second* appeal hereafter. Finally, if our cross-appeal stand dismissed, and if defendant's appeal be decided in *our* favor, the accounting will proceed as to claims 4 and 5 only; and if thereafter, on a *future* appeal, we succeed as to the other claims, there would have to be a second accounting, leaving room for a *third* appeal.

Even in another case cited as against the right to such cross-appeal, *Marden vs. Campbell* (67 F. R., 809), the distinction was noted between a case where the entire record was already before the Court of Appeals, and a case where a complainant sought to maintain his appeal independently. In short, the "reasoning" that warrants permitting defendants to appeal, is equally applicable and equally cogent in requiring that *complainants'* cross-appeal be entertained.

Accordingly, the Court of Appeals in the Seventh Circuit, upon the authority of the then recent decision of this Court in

Smith vs. *Vulcan* (165 U. S., *supra*) expressly sustained the right to the cross-appeal.

Chicago Wooden Ware Co. vs. Miller Ladder Co., 135 F. R., 541, 544–5.

This Court cited with approval the decision of the Court of Appeals for the Sixth Circuit, where it was said that if the Court of Appeals

> " obtained such a record as to enable it, with justice to the parties to the appeal, to hear and consider the merits of the case, it would be most anomalous if we have not the power to decide. The judicial function of considering involves the function of determining," etc.
>
> Bissell Carpet Sweeping Co. vs. Goshen Co., 72 F. R., 545, 560.

In the Second Circuit Judge WALLACE said:

> " Whenever the injunction is the main relief granted [and that is the case here] the whole case is necessarily presented for review."
>
> Florida Const. Co. vs. Young, 59 F. R., 721, 722.

Conclusions.

Our right to a cross-appeal has been demonstrated. The reasons why the Court of Appeals should consider our appeal concurrently with defendant's appeal, so as to avoid " piecemeal consideration," are fully set out in the second part of our petition.

Having been denied a plain right by the Court of Appeals, upon the ground that said Court has no *jurisdiction* to entertain our appeal, the writ of mandamus will lie; and because of the conflicting decisions in different circuits, *Certiorari* is proper.

Defendant's appeal now stands docketed for an early hearing by the Court of Appeals. Its counsel have given notice that they will claim a *Preference;* unless this Court renders its decision promptly, requiring the Court of Appeals to reinstate our cross-appeal, we will be compelled to argue the sole appeal of defendant; or the entire matter will have to be postponed until next Autumn or later, while defendant in the meantime will continue its infringement.

Therefore, we respectfully urge a prompt decision, either by way of mandamus or upon *certiorari*, directing the Court of Appeals to reinstate or cross-appeal.

New York City, January 8, 1906.

Respectfully submitted,

PHILIP MAURO,
HAROLD BINNEY,
C. A. L. MASSIE,
Of Counsel for Petitioner.

SUPREME COURT OF THE UNITED STATES.

No. 18, ORIGINAL, OCTOBER TERM, 1905.

EX PARTE IN THE MATTER OF AUTOMATIC SWITCH COMPANY OF BALTIMORE CITY, PETITIONER.

On consideration of the petition for a writ of mandamus herein,

IT IS NOW HERE ORDERED BY THE COURT that cause be shown by the Judges of the United States Circuit Court of Appeals for the Second Circuit before this Court at the City of Washington, on Monday, January 29th, 1906, at twelve o'clock noon of that day, or as soon thereafter as counsel can be heard, why the prayer of said petition should not be granted.

January 15, 1906.

[redacted]

[redacted]

[redacted]

[redacted]

[redacted]

[redacted]

[redacted]

[redacted]

[redacted]

Supreme Court of the United States.

NO. 18, ORIGINAL, OCTOBER TERM, 1905.

EX PARTE.

AUTOMATIC SWITCH COMPANY OF BALTIMORE CITY, PETITIONER.

STATE OF NEW YORK }
County of New York } ss.

C. A. L. MASSIE, being duly sworn, deposes and says he is of counsel for Petitioner herein, that he verified the Petition herein, and that the annexed nine papers are true copies of the original documents referred to in said Petition, and now on file either in the office of the Clerk of the Circuit Court of the United States for the Southern District of New York, or in the office of the Clerk of the Circuit Court of Appeals for the Second Circuit.

C. A. L. MASSIE.

Subscribed and sworn to before me this 20th day of January, 1906.

RALPH LANE SCOTT,
Notary Public,
New York County.

(SEAL)

At a Stated Term of the Circuit Court of the United States for the Southern District of New York, held in the Court Room thereof in the Federal Building in the Borough of Manhattan and City of New York this 20th day of April, 1905.

Present: Hon. William K. Townsend, United States Circuit Judge.

Automatic Switch Company of Baltimore City vs. Cutler-Hammer Manufacturing Company.	In Equity. No. 7827. On Whittingham Patent No. 499,769.

Interlocutory Decree.

This cause having come on to be heard on Jan. 13, 1905, upon amended bill of complaint, answer, replication, and proofs and exhibits on behalf of each party; and Philip Mauro, Esq., and C. A. L. Massie, Esq., having been heard for complainant and W. Clyde Jones, Esq., for defendant, and printed briefs having been submitted on each side; and a written opinion having been entered herein on Mar. 3, 1905; now, in conformity with said opinion, and on motion of Complainant's solicitor, Elisha K. Camp, Esq., it is this day—

Adjudged, ordered, and decreed that Complainant is a Maryland corporation entitled to maintain this suit and is possessed of the exclusive and beneficial ownership of the Letters-patent here in suit and of the invention therein set out and of all claims for infringement thereof; that the said Letters-patent

No. 499,769, granted June 20, 1893, to George Herbert Wittingham, as to Claims 4, 5, 6, 7, and 8 thereof, is good and valid in law; and that Defendant has a regular and established place of business within the Southern District of New York, and has infringed upon Claims 4 and 5 of said Letters-patent and upon Complainant's exclusive rights in the premises, by making and causing to be made, using and causing to be used, and selling and causing to be sold, within the Southern District of New York and elsewhere within the United States, "Regulators for Electric Motors" or "Automatic Switches" like "Complainant's Exhibit, Defendant's Apparatus", known also as Cutler-Hammer "Self Starters"; it is further

ADJUDGED, ORDERED, AND DECREED that a perpetual injunction issue out of and under the seal of this Honorable Court, against the defendant, enjoining and restraining said defendant and its successors, assigns, associates, attorneys, officers, servants, clerks, agents, and workmen, and each of them, forever from directly or indirectly making or causing to be made, using or causing to be used, selling or causing to be sold, any Regulator for Electric Motors or Automatic Switch or Self Starter like or substantially similar to the construction set forth in Claims 4 and 5 of said Letters-patent No. 499,769, or in either of said Claims; or like or substantially similar to the "Self Starter" apparatus made an exhibit herein as "Complainant's Exhibit, Defendant's Apparatus"; it is further

ADJUDGED, ORDERED, AND DECREED that this cause be referred to John A. Shields, Esquire, one of the Masters of this Court, he being especially qualified by reason of his experience in these matters, to ascertain and report to this Court an account of the number of infringing Automatic Switches or Self Starters either directly or indirectly made or used or sold by the said defendant in infringement of Claims 4 and 5 of the patent in suit, likewise of the number of such articles which the said defendant has on hand or under its control; and also

a statement of the gains, profits and advantages which the said defendant has received or which have accrued to it from or through the said infringement; and, further, to assess the damages the complainant has suffered in the premises, and to report all the foregoing to this Court with all convenient speed;

And that upon such an accounting the Complainant shall have the right to cause an examination of said defendant *ore tenus*, by commission, or otherwise, and also the production of the books, vouchers, exhibits, statements, documents, and machinery and premises of said defendant, as the said Master may direct; and that the said defendant attend for such purpose from time to time as the said Master shall direct; and it is further

ADJUDGED, ORDERED, AND DECREED that the defendant pay to the complainant one-half ot the costs, charges and disbursements of this suit, to be taxed by the Clerk; and that complainant have execution therefor against said defendant.

W. K. TOWNSEND,
U. S. Circuit Judge.

Approved as to form.

Order Suspending Injunction.

At a Stated Term of the United States Circuit Court, held in and for the Southern District of New York at the United States Courts and Post Office Building on the 21st day of April, 1905.

Present—Hon. William K. Townsend, Circuit Judge.

The Automatic Switch Company of Baltimore City, Complainant, against The Cutler-Hammer Manufacturing Company, Defendant.	In Equity. No. 7827.

A motion having been made herein on behalf of defendant for an order staying the issuance of injunction herein or suspending the operation of said injunction during the pendency of the appeal to be taken from the interlocutory decree to be entered herein upon such terms as to bond or otherwise as the Court may consider proper for the securing of the rights of complainant, and for such other and further relief in the premises as to the Court may seem just, and said motion having been duly noticed for March 17th, 1905, and thereupon having been adjourned by the direction of the Court and referred to Hon. William K. Townsend for hearing, and said motion having been duly brought on for argument on the 10th day of April, 1905,

Now, upon reading and filing the affidavit of Seward Davis, duly verified March 13th, 1905, the three affi-

davits of Arthur Berresford, duly verified March 11th and 13th, 1905, respectively, and the affidavit of Richard H. Mansfield, Jr., duly verified the 15th day of March, 1905, the affidavit of Marcellus Staley, duly verified the 15th day of March, 1905, and a certified copy of a certain assignment in writing dated July 10, 1902, duly executed and delivered by complainant herein and recorded the 12th day of July, 1902, in the Patent Office of the United States of Letters Patent No. 499,769, granted to George H. Whittingham on the 20th day of June, 1893, for Improvement in Regulators for Electric Motors, to Otis Elevator Company, and the affidavit of Frank R. Bacon, duly verified on the 8th day of April, 1905, filed on behalf of defendant in support of said motion, and the affidavit of C. A. L. Massie, duly verified the 10th day of April, 1905, and the affidavit of David H. Darrin, duly verified the 5th day of April, 1905, and a copy of assignment of said Letters Patent No. 499,769, dated April 6, 1905, from said Otis Elevator Company to The Automatic Switch Company, and after hearing W. Clyde Jones, Esq., in support of said motion, and C. A. L. Massie, Esq., and Harold Binney, Esq., in opposition thereto, and due consideration having been had, it is

ORDERED, that the issuance of injunction herein, pursuant to the terms of the interlocutory decree made and entered herein on the 20th day of April, 1905, be and hereby is stayed, upon the filing by defendant of a bond in the sum of Five Thousand Dollars and its approval as to sufficiency of surety by a judge of this Court, within ten days, until the hearing and determination, in due course, of an appeal to be taken from the interlocutory decree aforesaid to the United States Circuit Court of Appeals.

WM. K. TOWNSEND,
U. S. Judge.

Defendant's Appeal.

UNITED STATES CIRCUIT COURT,

SOUTHERN DISTRICT OF NEW YORK.

THE AUTOMATIC SWITCH COMPANY OF BALTIMORE CITY, Complainant, AGAINST THE CUTLER-HAMMER MANUFACTURING COMPANY, Defendant.	In Equity, No. 7827

The above-named defendant, The Cutler-Hammer Manufacturing Company, conceiving itself to be aggrieved by the decree made and entered on the 20th day of April, 1905, in the above-entitled cause, does hereby appeal from the said order and decree to the United States Circuit Court of Appeals for the Second Circuit, for the reasons specified in the assignment of errors, which is filed herewith, and prays that this its appeal may be allowed, and that a transcript of the record and papers upon which said order was made and of all the proceedings in the cause, duly authenticated, may be sent to the United States Circuit Court of Appeals for the Second Circuit.

Dated New York City,

SEWARD DAVIS,
JONES & ADDINGTON,
Solicitors for Defendant.

The foregoing claim of appeal is allowed.
Dated, New York City, May 12th, 1905.

E. HENRY LACOMBE,
U. S. Circuit Judge.

At a Stated Term of the Circuit Court of the United States for the Southern District of New York held in the Court Room thereof in the Post Office Building in the Borough of Manhattan and City of New York, this 26th day of May, 1905.

Present: Hon. William K. Townsend,
U. S. Circuit Judge.

Automatic Switch Company of Baltimore City, vs. Cutler-Hammer Mfg. Co.	In Equity. No. 7827. On Whittingham Patent No. 499,769.

Final Decree as to Claims 6, 7, and 8.

This cause coming on to be heard before me on January 13, 1905, upon amended bill of complaint, Answer, Replication, and proofs and exhibits on behalf of each party; and Philip Mauro, Esq., and C. A. L. Massie, Esq., having been heard for complainant, and W. Clyde Jones, Esq., for defendant; and printed briefs having been submitted on each side; and a written opinion having been filed herein on March 3, 1905; and an Interlocutory Decree in accordance therewith entered on April 20, 1905, holding Claims 4 to 8 inclusive of the Whittingham patent here in suit to be good and valid in law, but awarding complainant an injunction and accounting only as to Claims 4 and 5 with only one-half of its taxable costs (all as will more fully appear by said Interlocutory Decree itself on file in this Court); now, in further conformity with

said opinion, and on motion of Elisha K. Camp, Esq., Complainant's solicitor, it is this day

ADJUDGED, ORDERED, AND DECREED that the bill of complaint herein be and the same hereby is dismissed as to Claims 6, 7, and 8 of the Whittingham patent here in suit, as not being infringed by defendant; and that the provision of the said Interlocutory Decree as to costs be reaffirmed.

WM. K. TOWNSEND,
U. S. C. J.

Complainant's Appeal.

IN THE CIRCUIT COURT OF THE UNITED STATES

FOR THE SOUTHERN DISTRICT OF NEW YORK.

AUTOMATIC SWITCH COMPANY OF BALTIMORE CITY, vs. CUTLER-HAMMER MFG. COMPANY.	In Equity, No. 7827.

Appeal.

The above-named complainant, considering itself aggrieved by the Final Decree of this Court, filed and entered herein on the 26th day of May, 1905, and dismissing the bill of complaint herein as to Claims 6, and 7, and awarding complainant only one-half its taxable costs and disbursements, does hereby appeal to the United States Circuit Court of Appeals for the Second Circuit, and prays that its appeal may be allowed and citation granted, directed to the above-named defend-

ant, and commanding it to appear before the said Cir-Cuit Court of Appeals, to do and receive what may appertain to justice to be done in the premises, and that a transcript of the pleadings and proofs, exhibits, evidence, records and proceedings in said cause, duly authenticated, may be sent to the United States Circuit Court of Appeals for the Second Circuit.

Dated New York City, June 7, 1905.

ELISHA K. CAMP,
Solicitor for Complainant,
90 West Broadway,
New York City.

The proper security for costs having been given herein in the sum of $250.00, and the Undertaking being now in full force and effect and on file in the Office of the Clerk of this Court, it is

ORDERED that the foregoing appeal be and the same is hereby allowed.

Dated June 7, 1905.

E. H. LACOMBE,
U. S. C. J.

IN THE CIRCUIT COURT OF THE UNITED STATES

FOR THE SOUTHERN DISTRICT OF NEW YORK.

AUTOMATIC SWITCH COMPANY OF BALTIMORE CITY, vs. CUTLER-HAMMER MFG. CO.	In Equity No. 7827. On Whittingham Patent No. 499,769.

Assignment of Errors.

And now comes the above-named Automatic Switch Company of Baltimore City, complainant and cross-appellant herein, by Elisha K. Camp, Esq., its solicitor, and having prayed an appeal to the United States Circuit Court of Appeals for the Second Circuit from the "Final Decree as to Claims 6, 7, and 8" of the said Circuit Court entered herein on the 26th day of May, 1905, respectfully represents as grounds for appeal, and as an assignment of errors herein, that the Circuit Court erred in the following particulars:

1. The Court erred in dismissing the bill as to Claims 6 and 7 of the patent in suit;

2. The Court erred in not holding Claim 6 of the patent in suit to be infringed by defendant's apparatus;

3. The Court erred in not holding Claim 7 of the patent in suit to be infringed by defendant's apparatus;

4. The Court erred in not granting an injunction and accounting against defendant as to Claim 6;

5. The Court erred in not granting an injunction and accounting against defendant as to Claim 7;

6. The Court erred in not holding that the mass of iron at the top of defendant's apparatus is the iron cap of the patent in suit or the equivalent thereof;

7. The Court erred in limiting complainant to the recovery of only one-half its costs;

WHEREFORE, the complainant prays that the final decree aforesaid may be reversed and annulled as to said Claims 6 and 7; and that this Court be directed to enter a decree ordering (in addition to the relief granted in and by said Interlocutory Decree of April 20, 1905), an injunction and accounting as to said Claims 6 and 7, with all costs to Complainant.

New York City, June 7, 1905.

ELISHA K. CAMP,
Solicitor for Complainant.

Motion to Dismiss.

UNITED STATES CIRCUIT COURT OF APPEALS

FOR THE SECOND JUDICIAL CIRCUIT.

AUTOMATIC SWITCH COMPANY OF BALTIMORE CITY, Complainant-Appellee and Cross-Appellant, AGAINST THE CUTLER-HAMMER MANUFACTURING COMPANY, Defendant-Appellant and Cross-Appellee.	In Equity, Calendar No. 118

SIR: Please take notice that on Tuesday, October 10, 1905, at the opening of the United States Circuit Court of Appeals, or as soon thereafter as the matter

can be heard, a motion will be made on behalf of The Cutler-Hammer Manufacturing Company to dismiss the cross-appeal of the said Automatic Switch Company of Baltimore City.

The ground upon which said motion will be based is that the court has no jurisdiction to entertain the said cross-appeal.

Dated, New York, N. Y., September 23, 1905.

SEWARD DAVIS,
Solicitor for The Cutler-Hammer Manufacturing Company, Defendant-Appellant and Cross-Appellee,
29 Liberty Street,
Borough of Manhattan,
New York City.

ELISHA K. CAMP, ESQ.,
Solicitor for Automatic Switch Company of Baltimore City, Complainant-Appellee and Cross-Appellant, 90 West Broadway, Borough of Manhattan, New York City.

Order of Dismissal.

IN THE UNITED STATES CIRCUIT COURT OF APPEALS

FOR THE SECOND CIRCUIT.

Present: HONS. W. J. WALLACE, E. H. LACOMBE, and A. C. COXE, United States Circuit Judges.

AUTOMATIC SWITCH COMPANY OF BALTIMORE CITY, Complainant-Appellee and Cross-Appellant, vs. THE CUTLER-HAMMER MFG. CO., Defendant-Appellant and Cross-Appellee.	In Equity. Calendar No. 118.

This cause coming on to be heard upon motion by the said Cutler-Hammer Mfg. Company to dismiss the cross-appeal of the said Automatic Switch Company of Baltimore City, upon the ground that this Court has no jurisdiction to entertain the said cross-appeal; and W. Clyde Jones, Esq., being heard for the motion, and C. A. L. Massie, Esq., being heard in opposition, and each party having filed a printed brief; and the Court being duly advised in the premises;

Now, therefore, it is hereby adjudged, ordered, and decreed that the said motion be and the same hereby is granted and that the said cross-appeal taken by the said Automatic Switch Company of Baltimore City be and the same hereby is dismissed upon the ground that this Court has no jurisdiction to entertain the same.

Dated Jan. 3/06.

(Sgd) E. H. L.
A. C. C.

FOLDOUT(S) IS/ARE TOO LARGE TO BE FILMED

Supreme Court of the United States,

No. 18, ORIGINAL, OCTOBER TERM, 1905.

Ex parte

IN THE MATTER

OF

AUTOMATIC SWITCH COMPANY OF BALTIMORE CITY,

Petitioner.

The return of the Judges of the United States Circuit Court of Appeals for the Second Circuit to the rule upon them to show cause why a writ of peremptory mandamus should not issue commanding them in said court to entertain an appeal of said petitioner from a decree entered in the cause entitled Automatic Switch Company of Baltimore City vs. The Cutler Hammer Manufacturing Company.

The respondents respectfully answer and certify to the Honorable Supreme Court of the United States:

(1) That after pleadings filed and issue joined in said cause and after arguments of counsel for both sides, and final hearing upon proofs theretofore taken in said cause, the Honorable WILLIAM K. TOWNSEND, Circuit Judge, sitting as a Judge of the United States Circuit Court for the Southern District of New York, filed on March 3rd, 1905 an opinion finding infringement of claims 4 and 5 of letters patent No. 499,769, granted June 20, 1893 to G. H. Whittingham for a Regulator

for Electric Motors, and finding claims 6, 7 and 8 of said letters patent not infringed.

(2) That thereafter an interlocutory decree was entered by said Circuit Judge, the same having been filed April 20th, 1905, and reading as follows, to wit:

"At a Stated Term of the Circuit Court of the United States for the Southern District of New York, held in the Court Room thereof in the Federal Building, in the Borough of Manhattan and City of New York, this 20th day of April, 1905.

"Present—HON. WILLIAM K. TOWNSEND,
United States Circuit Judge.

"AUTOMATIC SWITCH COMPANY OF BALTIMORE CITY

vs.

"CUTLER-HAMMER MANUFACTURING COMPANY.

In Equity.
No. 7827.
On Whittingham Patent No. 499,769.

"INTERLOCUTORY DECREE.

"This cause having come on to be heard on Jan. 13, 1905, upon amended bill of complaint, answer, replication, and proofs and exhibits on behalf of each party; and Philip Mauro, Esq., and C. A. L. Massie, Esq., having been heard for complainant, and W. Clyde Jones, Esq., for defendant, and printed briefs having been submitted on each side, and a written opinion having been entered herein on Mar. 3, 1905, now, in conformity with said opinion, and on motion of Complainant's Solicitor, Elisha K. Camp, Esq., it is this day

"Adjudged, ordered and decreed that complainant is a Maryland corporation, entitled to maintain this suit and is possessed of the exclusive and beneficial ownership of the Letters Patent here in suit and of the invention therein set out and of all claims for infringement

thereof; that the said Letters Patent No. 499,769, granted June 20, 1893, to George Herbert Whittingham, as to Claims 4, 5, 6, 7 and 8 thereof, is good and valid in law; and that defendant has a regular and established place of business within the Southern District of New York, and has infringed upon Claims 4 and 5 of said Letters Patent and upon complainant's exclusive rights in the premises, by making and causing to be made, using and causing to be used, and selling and causing to be sold, within the Southern District of New York and elsewhere within the United States, 'Regulators for Electric Motors' or 'Automatic Switches' like 'Complainant's Exhibit, Defendant's Apparatus'; known also as Cutler-Hammer 'Self Starters'; it is further

"Adjudged, ordered and decreed that a perpetual injunction issue out of and under the seal of this Honorable Court against the defendant, enjoining and restraining said defendant, and its successors, assigns, associates, attorneys, officers, servants, clerks, agents, and workmen, and each of them, forever from directly or indirectly making or causing to be made, using or causing to be used, selling or causing to be sold, any regulator for Electric Motors or Automatic Switch or Self Starter like or substantially similar to the construction set forth in Claims 4 and 5 of said Letters Patent No. 499,769, or in either of said Claims; or like or substantially similar to the 'Self Starter' apparatus made an exhibit herein, as 'Complainant's Exhibit, Defendant's Apparatus'; it is further

"Adjudged, ordered and decreed that this cause be referred to John A. Shields, Esquire, one of the Masters of this Court, he being especially qualified by reason of his experience in these matters, to ascertain and report to this Court an account of the number of infringing Automatic Switches or Self Starters, either directly or indirectly, made or used or sold, by the said defendant in infringement of Claims 4 and 5 of the patent in suit, likewise of the number of such articles which the said defendant has on hand or under its control, and also a statement of the gains, profits and advantages

which the said defendant has received or which have accrued to it from or through the said infringement, and, further, to assess the damages the complainant has suffered in the premises, and to report all the foregoing to this Court with all convenient speed;

"And that upon such an accounting the complainant shall have the right to cause an examination of said defendant *ore tenus*, by commission, or otherwise, and also the production of the books, vouchers, exhibits, statements, documents and machinery and premises of said defendant, as the said Master may direct; and that the said defendant attend for such purpose from time to time as the said Master shall direct; and it is further

"Adjudged, ordered and decreed that the defendant pay to the complainant one-half of the costs, charges and disbursements of this suit, to be taxed by the Clerk; and that complainant have execution therefor against said defendant.

"W. K. TOWNSEND,
U. S. Circuit Judge.

"Approved as to form.

"(ENDORSED)—In the Circuit Court of the United States, for the Southern District of New York.—Automatic Switch Company vs. Cutler-Hammer Mfg. Co. In Equity, Docket No. 7827, Whittingham Patent, —Interlocutory Decree for Injunction.—Philip Mauro. For Complainant, 277 Broadway, New York City.—March 7, 1905.—Copy received at 2.55 P. M. Seward Davis. And notice objected to as insufficient.—U. S. Circuit Court, Southern District of New York.—Filed Apr. 20, 1905.—John A. Shields, Clerk."

(3) That thereafter an appeal was taken by defendant, The Cutler-Hammer Mfg. Co., from said interlocutory decree, filed April 20, 1905, said appeal and the allowance thereof being as follows, to wit:

"UNITED STATES CIRCUIT COURT,

"SOUTHERN DISTRICT OF NEW YORK.

"THE AUTOMATIC SWITCH COMPANY OF BALTIMORE CITY, Complainant, AGAINST "THE CUTLER-HAMMER MANUFACTURING COMPANY, Defendant.	In Equity. No. 7827.

"The above named defendant, The Cutler-Hammer Manufacturing Company, conceiving itself to be aggrieved by the decree made and entered on the 20th day of April, 1905, in the above entitled cause, does hereby appeal from the said order and decree to the United States Circuit Court of Appeals for the Second Circuit, for the reasons specified in the Assignment of errors, which is filed herewith, and prays that this its appeal may be allowed, and that a transcript of the record and papers upon which said order was made and of all the proceedings in the cause, duly authenticated, may be sent to the United States Circuit Court of Appeals for the Second Circuit.

"Dated New York City, May 12, 1905.

"SEWARD DAVIS,
"JONES & ADDINGTON,
"Solicitors for Defendant.

"The foregoing claim of appeal is allowed.

"Dated New York City, May 12, 1905.

"E. HENRY LACOMBE,
"U. S. Circuit Judge.

"[ENDORSED.] United States Circuit Court, Southern District of New York.—In Equity, No. 7827.—The Au-

tomatic Switch Company of Baltimore City, Complainant, against The Cutler-Hammer Manufacturing Company, Defendant.—Petition for an allowance of Appeal. —Seward Davis, Jones & Addington, Solicitors for Defendant, 29 Liberty Street, New York City.—Due service of the within Petition for an Allowance of Appeal is hereby admitted this 13th day of May, 1905.—Elisha K. Camp, Solicitor for Complainant.—U. S. Circuit Court, Southern District of New York.—Filed May 13, 1905.—John A. Shields, Clerk."

(4) That an assignment of errors was filed by said defendant May 12th, 1905.

(5) That citation to the Automatic Switch Company of Baltimore City, complainant, pursuant to the appeal by defendant was issued and duly served upon complainant, said citation being as follows, to wit :

" UNITED STATES CIRCUIT COURT OF APPEALS,

" FOR THE SECOND CIRCUIT.

" UNITED STATES OF AMERICA, } ss. :
" Second Judicial Circuit, }

TO THE AUTOMATIC SWITCH COMPANY OF BALTIMORE CITY, GREETING :

" You are hereby cited and admonished to be and appear at a session of the United States Circuit Court of Appeals for the Second Circuit, to be holden at the City of New York in said Circuit, on the 9th day of June, 1905, pursuant to the petition for appeal filed in the Clerk's Office of the Circuit Court of the United States for the Southern District of New York, and duly allowed, wherein The Cutler-Hammer Manufacturing Company is defendant-appellant and The Automatic Switch Company of Baltimore City is complainant-appellee, to show cause, if any there be, why the interlocutory decree granted against the said defendant-

appellant, as in the said petition for appeal mentioned, should not be corrected, and why speedy justice should not be done to the parties in that behalf.

"Witness, the Honorable E. HENRY LACOMBE, Circuit Judge of the United States at the City of New York, within said Circuit, this 12th day of May, in the year of our Lord one thousand nine hundred and five, and of the Independence of the United States the one hundred and twenty-ninth.

"E. HENRY LACOMBE,
"United States Circuit Judge.

"[ENDORSED]—United States Circuit Court, Southern District of New York. In Equity, No. 7827.—The Automatic Switch Company, of Baltimore City, Complainant, against the Cutler-Hammer Manufacturing Company, Defendant.—Citation on Appeal.—Seward Davis, Solicitor for Defendant, 29 Liberty Street, New York City.—Due service of the within Citation on appeal is hereby admitted this 13th day of May, 1905.—Elisha K. Camp, Solicitor for Complainant.—U. S. Circuit Court, Southern District of New York.—Filed May 13, 1905.—John A. Shields, Clerk."

(6) That thereafter a second decree was entered and filed in said cause, said decree having been filed May 26th, 1905, the decree and the affidavit of service thereof reading as follows, to wit:

"At a Stated Term of the Circuit Court of the United States for the Southern District of New York, held in the Court Room thereof, in the Post-Office Building, in the Borough of Manhattan and City of New York, this 26th day of May, 1905.

"Present—HON. WILLIAM K. TOWNSEND,
"U. S. Circuit Judge.

AUTOMATIC SWITCH COMPANY OF BALTIMORE CITY vs. CUTLER-HAMMER MFG. CO.	In Equity, No. 7827. On Whittingham Patent No. 499,769.

"FINAL DECREE AS TO CLAIMS 6, 7 AND 8.

"This cause coming on to be heard before me on January 13, 1905, upon amended bill of complaint, Answer, Replication and proofs and exhibits on behalf of each party; and Philip Mauro, Esq., and C. A. L. Massie, Esq., having been heard for complainant, and W. Clyde Jones, Esq., for defendant; and, printed briefs having been submitted on each side; and a written opinion having been filed herein on March 3, 1905; and an interlocutory Decree in accordance therewith entered on April 20, 1905, holding Claims 4 to 8 inclusive of the Whittingham patent here in suit to be good and valid in law, but awarding complainant an injunction and accounting only as to Claims 4 and 5 with only one-half of its taxable costs (all as will more fully appear by said Interlocutory Decree itself on file in this Court); now, in further conformity with said opinion; and on motion of Elisha K. Camp, Esq., Complainant's solicitor, it is this day

"Adjudged, ordered and decreed that the bill of complainant herein be and the same hereby is dismissed as to Claims 6, 7 and 8 of the Whittingham

patent here in suit, as not being infringed by defendant; and that the provision of the said Interlocutory decree as to costs be reaffirmed.

" Wm. K. Townsend,
" *U. S. C. J.*

" IN THE CIRCUIT COURT OF THE UNITED STATES.

" For the Southern District of New York.

" Automatic Switch Company of Baltimore City vs. Cutler-Hammer Mfg. Co.	In Equity. No. 7827. On Whittingham Patent No. 499,769.

" Harting Affidavit of Service.

" State of New York, } ss.
" County of New York, }

Willard H. Harting, being duly sworn, deposes and says: That he is twenty-one years of age and upwards. That on the 22nd day of May, 1905, between the hours of three and four o'clock P. M., at the office of Seward Davis, Esq., 29 Liberty Street, Borough of Manhattan, City of New York, he served a copy of the annexed Notice and Final Decree as to claims 6, 7 and 8 upon Seward Davis, Esq., in this action by delivering to and leaving with the said Seward Davis, Esq., personally, a true copy thereof.

" Willard H. Harding.

" Subscribed and sworn to before me this 22nd day of May, 1905.

Elisha K. Camp,
Notary Public,
New York County.

(Seal.)

" (Endorsed)—In the Circuit Court of the United States for the Southern District of New York.—Auto-

matic Switch Company of Baltimore City vs. Cutler-Hammer Mfg. Co.—In Equity, Docket No. 7827.—Whittingham Patent No. 499,769—Notice and Final Decree as to Claims 6, 7 and 8 and affidavit of service. —Philip Mauro, for Complainant, 90 West Broadway, New York City.—U. S. Circuit Court, Southern District of New York.—Filed May 26, 1905.—John A. Shields, Clerk."

(7) That thereafter complainant appealed from said second decree, said appeal having been filed June 7th, 1905, and reading as follows, to wit :

"IN THE CIRCUIT COURT OF THE UNITED STATES

"FOR THE SOUTHERN DISTRICT OF NEW YORK.

"AUTOMATIC SWITCH COMPANY OF BALTIMORE CITY vs. CUTLER-HAMMER MFG. COMPANY.	In Equity. No. 7827.

"APPEAL.

"The above-named complainant, considering itself aggrieved by the Final Decree of this Court, filed and entered herein on the 26th day of May, 1905, and dismissing the bill of complaint herein as to claims 6 and 7, and awarding complainant only one-half its taxable costs and disbursements, does hereby appeal to the United States Circuit Court of Appeals for the Second Circuit, and prays that its appeal may be allowed and citation granted, directed to the above-named defendant, and commanding it to appear before the said Circuit Court of Appeals to do and receive what may appertain to justice to be done in the

premises, and that a transcript of the pleadings and proofs, exhibits, evidence, records and proceedings in said cause, duly authenticated, may be sent to the United States Circuit Court of Appeals for the Second Circuit.

"Dated New York City, June 7, 1905.

"ELISHA K. CAMP,
"Solicitor for Complainant,
"90 West Broadway,
"New York City.

"The proper security for costs having been given herein in the sum of $250.00, and the Undertaking being now in full force and effect and on file in the Office of the Clerk of this Court, it is

"Ordered, that the foregoing appeal be and the same is hereby allowed.

"Dated June 7, 1905.

"E. H. LACOMBE,
"*U. S. C. J.*

"(ENDORSED)—In the Circuit Court of the United States for the Southern District of New York.—Automatic Switch Company of Balimore City vs. Cutler-Hammer Mfg. Co.—In Equity, Docket No. 7827.—Appeal.—Philip Mauro, for Complainant-Appellant, 90 West Broadway, New York City.—Due and timely service of a copy of the within Appeal is hereby admitted.—Dated June 7, 1905.—Seward Davis, Solicitor for Defendant.—U. S. Circuit Court, Southern District of New York.—Filed Jun. 7, 1905.—John A. Shields, Clerk."

(8) That an assignment of errors was filed by complainant June 7th, 1905, said assignment of errors reading as follows, to wit:

" IN THE CIRCUIT COURT OF THE UNITED STATES

" FOR THE SOUTHERN DISTRICT OF NEW YORK.

" AUTOMATIC SWITCH COMPANY OF BALTIMORE CITY VS. " CUTLER-HAMMER MFG. CO.	In Equity. No. 7827 On Whittingham Patent No. 499,769.

" ASSIGNMENT OF ERRORS.

" And now comes the above-named Automatic Switch Company of Baltimore City, complainant and cross-appellant herein, by Elisha K. Camp, Esq., its solicitor, and having prayed an appeal to the United States Circuit Court of Appeals for the Second Circuit from the 'Final Decree as to Claims 6, 7 and 8' of the said Circuit Court entered herein on the 26th day of May, 1905, respectfully represents as grounds for appeal, and as an assignment of errors herein, that the Circuit Court erred in the following particulars :

" 1. The Court erred in dismissing the bill as to Claims 6 and 7 of the patent in suit ;

" 2. The Court erred in not holding Claim 6 of the patent in suit to be infringed by defendant's apparatus ;

" 3. The Court erred in not holding Claim 7 of the patent in suit to be infringed by defendant's apparatus ;

" 4. The Court erred in not granting an injunction and accounting against defendant as to Claim 6 ;

" 5. The Court erred in not granting an injunction and accounting against defendant as to claim 7 ;

" 6. The Court erred in not holding that the mass of iron at the top of defendant's apparatus is the iron cap of the patent in suit or the equivalent thereof ;

" 7. The Court erred in limiting complainant to the recovery of only one-half its costs ;

" Wherefore, the complainant prays that the final decree aforesaid may be reversed and annulled as to said

Claims 6 and 7; and that this Court be directed to enter a decree ordering (in addition to the relief granted in and by said interlocutory decree of April 20, 1905), an injunction and accounting as to said Claims 6 and 7, with all costs to Complainant.

" New York City, June 7th, 1905.

" ELISHA K. CAMP,

" Solicitor for Complainant.

" (ENDORSED:)—In the Circuit Court of the United States for the Southern District of New York.—Automatic Switch Company of Baltimore City vs. Cutler-Hammer Mfg. Co.—In Equity, Docket No. 7827.—Assignment of Errors.—Philip Mauro, for Complainant, 90 West Broadway, New York City.—U. S. Circuit Court, Southern District of New York.—Filed Jun. 7, 1905.—John A. Shields, Clerk."

(9) That thereafter a transcript of the record and proceedings had in the Circuit Court was prepared by John A. Shields, Clerk of said Circuit Court and certified to by him June 9th, 1905.

(10) That thereafter, on June 9th, 1905, said transcript was filed with the clerk of the United States Circuit Court of Appeals for the Second Circuit.

(11) That in accordance with the rules and practice of said Circuit Court, where an appeal is taken by both the complainant and the defendant, the parties may agree that one certification and one transcript of record may be made up, containing the papers and documents upon which both parties expect to rely, the cost thereof to be equally borne by the parties in the first instance, the apportionment of the costs thereafter to be determined by the Circuit Court of Appeals; that a joint record in this cause was made up by the complainant and defendant after the two appeals had been allowed.

(12) That on October 10, 1905, motion was made by defendant to dismiss complainant's appeal on the ground that this court has no jurisdiction to entertain the said appeal of

complainant; that said motion was thereafter set for oral argument and arguments were made by W. Clyde Jones, Esq., in support of the motion and by C. A. L. Massie, Esq., in opposition to the motion; that briefs were thereupon filed by both parties and after a consideration thereof, an order was entered by this court on January 3rd, 1906, granting said motion and dismissing the appeal of complainant, said order being as follows, to wit:

"IN THE UNITED STATES CIRCUIT COURT OF APPEALS

"For the Second Circuit.

"Present: Hons. W. J. Wallace, E. H. Lacombe, and A. C. Coxe, United States Circuit Judges.

"Automatic Switch Company of Baltimore City, "Complainant-Appellee and "Cross-Appellant, vs. "The Cutler-Hammer Mfg. Co., "Defendant-Appellant and "Cross-Appellee.	In Equity, Calendar No. 118.

"This cause coming on to be heard upon motion by the said Cutler-Hammer Mfg. Company to dismiss the cross-appeal of the said Automatic Switch Company of Baltimore City, upon the ground that this Court has no jurisdiction to entertain the said cross-appeal; and W. Clyde Jones, Esq., being heard for the motion, and C. A. L. Massie, Esq., being heard in opposition, and each party having filed a printed brief; and the Court being duly advised in the premises;

"Now, therefore, it is hereby ADJUDGED, ORDERED and DECREED that the said motion be and the same hereby is granted and that the said cross-appeal taken by the said Automatic Switch Company of Baltimore City be and

the same hereby is dismissed upon the ground that this Court has no jurisdiction to entertain the same.

" Dated, Jan. 3, 1906.

" A true copy.

" (Signed) WM. PARKIN,

" Clerk (SEAL).

(Sgd)
E. H. L.
A. C. C.
" Filed Jan. 3, 1906."

(13) Respondents denied the appeal by complainant for the reason that in the opinion of this court, this court was without jurisdiction to entertain said appeal and respondents now submit that no appeal was or is now demandable in law from the said decree from which complainant undertook to appeal.

(14) Respondents are advised that it is not necessary that they should make any other answer to the rule aforesaid than this herein contained, nor more specifically to any of the allegations set forth in the petition for mandamus aforesaid; and having fully answered said rule, they pray to be hence dismissed with all proper costs. And these are the causes and reasons which these respondents have offered why a mandamus should not issue, commanding them to entertain said appeal; but they respectfully submit to the judgment of this Honorable Court and will enforce by order, any direction given by the court in the premises.

WILLIAM J. WALLACE.

In signing the return we do not assent to the precise form in which the statement contained in paragraph (13) is expressed. It is our understanding that the appeal was dismissed because this court was of the opinion that the rule of *stare decisis* should control, and that whatever might be the individual opinions of the sitting members of the court, or of the majority thereof, the practice heretofore prevailing in this circuit should be followed.

E. H. LACOMBE,
ALFRED C. COXE,
U. S. Circuit Judges.

16 Orig.

FILE COPY.

In the Supreme Court of the United States.

OCTOBER TERM, 1905.

EX PARTE AUTOMATIC SWITCH COMPANY, OF BALTIMORE CITY.

Original. No. —.

BRIEF IN OPPOSITION TO MOTION.

W. CLYDE JONES,
Attorney for Respondent.

JOHN RIDOUT,
Of Counsel.

GILES & COLE, Printers, 317 Sixth St. N. W.

In the Supreme Court of the United States.

Ex Parte Automatic Switch Company, of Baltimore City.

Original. No. —.

BRIEF IN OPPOSITION TO MOTION.

From the statement of the case, it appears that an interlocutory decree was entered in the Circuit Court, from which, under section 7 of the Act of June 6, 1900, an appeal was taken to the Circuit Court of Appeals of the Second Circuit.

Thereafter the Switch Company obtained the entry of what is *called* a final decree dismissing the Bill in part and thereupon appealed from that decree.

The Cutler Hammer Company moved to dismiss this appeal on the ground that it was in reality an appeal from an interlocutory decree.

After due consideration, after oral argument and on briefs, the Circuit Court of Appeals dismissed the appeal of the Automatic Switch Company.

The dismissed appellant seeks to reverse this action of the Circuit Court of Appeals by the instrumentality of a writ of mandamus or certiorari and has filed motion for leave to file a petition for a writ of mandamus or certiorari.

While it is the proper practice to file a motion for leave to file a petition for writ of mandamus, it is believed to be quite unusual to file a motion for leave to file a petition for a writ of certiorari.

This motion cannot be treated as a petition for a writ of certiorari because it lacks essential requisites of such a petition, the principal being that the whole record is not presented. The notice required has also not been given.

ARGUMENT.

This is one more of the numerous efforts to use the writ of mandamus in place of an appeal.

If there is a settled rule in this court, it is that such use may not directly or indirectly be made of this writ.

Ex parte Schwab, 98 U. S., 240.
Ex parte Perry, 102 U. S., 186.

But there is a graver difficulty in this case:

The court has *acted* and while mandamus may be used to compel action, it can never be used to reverse action or to control judicial discretion.

See cases *supra*.

The remedy of the moving party is ample.

There is, as yet, no final decree below.

Either the pending appeal of the Cutler Hammer Company can reach only the injunction and when there shall have been an accounting and a true final decree, an appeal can be taken therefrom, and on that appeal the whole record will be open for review, or upon the pending appeal, the whole case can be considered and a mandate issued ac-

cordingly; ultimately there will be a final decree in the Circuit Court from which appeal can be taken to the Circuit Court of Appeals and *that final decree* can be reviewed here on certiorari, if a proper case is made.

Thus the consideration of causes on the merits piecemeal will be avoided.

If the motion could be considered as an application for a writ of certiorari the writ could not be granted, because:

A. The application is fatally incomplete, lacking the whole record:

B. There is no final decree, indeed no decree at all, of the Circuit Court of Appeals.

Smith *vs.* Vulcan Iron Works, 165 U. S., 518.

In its last analysis, this is a case in which the application for mandamus is *too late* and for certiorari *too early*.

Amer. Constrc. Co. *vs.* Jacksonville Ice Co., 148 U. S., 372.
In re Transport Co., 168 U. S., 583.
In re Massachusetts, 197 U. S., 482.
In re Glaser, 198 U. S., 171.

AS TO THE MERITS.

While we believe the motion of the Automatic Switch Company should be denied, for the reasons above stated, we submit herewith for the guidance of the court, should it wish to investigate the merits of the petition, the following considerations, showing that in view of the facts of this case, the relief sought should not be granted.

I.

The petition and the brief in support thereof, are based upon two misconceptions or misstatements as to the record and facts in this case.

(1.) The petition and brief assume that the first interlocutory decree entered April 20, 1905, found claims 6, 7 and 8, *not infringed* (page 3 and page 10). As a matter of fact, however, the interlocutory decree of April 20, 1905, found claims 4, 5, 6, 7 and 8, valid and claims 4 and 5 infringed, but made no finding as to claims 6, 7 and 8 *with respect to infringement*. This misconcept on or misstatement has an important bearing upon the moving party's position as will hereafter appear.

(2.) The petition and brief state that the *entire record* had been taken to the Court of Appeals by defendant *before* the appeal by complainant (page 3, page 4, 16, 17 and 19).

As a matter of fact at the date of complainant's appeal no transcript and no printed record had been made up. After complainant's appeal, pursuant to the practice of the court requiring each party to pay one-half the expenses of the appeal when both appeal, a stipulation was made providing that each party should furnish the necessary copies of its printed record, the additional expenses to be paid half and half. At the date, therefore, of complainant's appeal, there was *not* a *complete* record taken up by defendant upon which a cross appeal could be based or, in fact, any record.

II.

Three theories as to the nature of the two decrees have been presented by the opposing parties.

(1.) It is the position of the respondent to the motion that the decree of April 20, 1905, and the decree of May 26, 1905, are both interlocutory decrees.

(2.) It was the main contention of the moving party at the argument of the motion to dismiss the cross appeal that the first decree was interlocutory, while the second decree was final.

(3.) It appears to be the main contention of the moving party herein, that both decrees are interlocutory but constitute in effect a single decree.

It is submitted that the first of the above theories is the only one which is tenable.

III.

The chronology of events concerning the two appeals is as follows :

April 20, 1905, first decree entered and filed.

May 12, 1905, appeal by defendant from first decree.

May 13, 1905, citation to complainant.

May 26, 1905, second decree, so called "final" decree, entered and filed.

June 7, 1905, appeal by complainant from second decree.

June 9, 1905, transcript of record, containing documents specified by both parties, filed.

IV.

We submitt the following controlling propositions which are established by the authorities and the record in this case.

(1.) *The first decree entered April 20, 1905, is interlocutory.* This fact is not disputed. The decree,

"Adjudged, ordered and decreed * * * that the said letters patent No. 499,769, granted June 20, 1893 to George Herbert Whittingham, as to claims 4, 5, 6, 7 and 8 thereof, is good and valid in law; and that defendant * * * has infringed upon claims 4 and 5 of said letters patent."

The decree granted an injunction and an accounting as to claims 4 and 5.

This decree is interlooutory.

Smith & Vulcan Works 165 U. S., 518.

(2.) *The second decree entered May 24, 1905, is interlocutory and not final.* This decree:

"Adjudged, ordered and decreed that the Bill of Complainant herein be, and the same hereby is dismissed as to claims 6, 7 and 8 of the Whittingham patent herein suit, as not being infringed by defendant."

This decree still left before the Circuit Court the accounting on claims 4 and 5 and the control of the injunction. The decree is therefore not a final decree.

Dowagiac Mfg. Co. *v.* Superior Drill Co., 115 Fed. 886.

Marden *v.* Campbell Printing Press & Mfg. Co., 67 Fed. 809.

Eagle Lock Co. *v.* Griswold, 67 Fed. 789.

Kilmer Mfg. Co. *v.* Griswold, 67 Fed. 1017.

Western Electric Co. *v.* Williams-Abbott Electric Co, 108 Fed. 952.

In patent causes there cannot be two final decrees.

Marden *v.* Campbell Co., *supra*.

(3) *Defendant appealed May 12, 1905, under sec. 7 of the Judiciary Act of 1891 before the second decree was entered.*

The subsequent entry of the second decree cannot therefore affect or enlarge the appeal from the first decree.

(4.) *Complainant appealed June 7, 1905, from the second decree entered May 24, 1905.*

This was an independent appeal from a supposed final decree and not a cross appeal.

(5.) *Complainant's appeal cannot be sustained as an independent appeal from a final decree*, because the second decree was interlocutory, since it did not dispose of the entire litigation.

(6.) *Complainant's appeal cannot be sustained as an independent appeal from an interlocutory decree*, since the decree of May 24, 1905, appealed from, *refuses* an injunction and is, therefore, not appealable under sec. 7.

(7.) *Complainant's appeal cannot be sustained as a cross appeal from the interlocutory decree of April 20, 1905*, because that decree is wholly in favor of complainant and is not adverse in any particular.

(8.) *Complainant's appeal cannot be sustained as a cross appeal based on the subsequent decree of May 24, 1905*, because that decree was entered *after* the appeal had been perfected by defendant as to the first interlocutory decree.

(9.) *The two decrees cannot, for the purpose of appeal, be considered as one appeal*, because the Circuit Court had lost jurisdiction of the first decree by defendant's appeal before the second decree was entered.

(10.) *At the date of complainant's appeal, defendant had not taken up a complete record*, or in fact any record;

after both appeals had been taken, a joint record was made up; therefore, at the date of complainant's appeal there was no complete record before the Court of Appeals upon which a cross-appeal could be based.

V.

In view of the above propositions it is apparent that the first of the three theories as to the nature of the three decrees is the only one which is tenable.

(1.) Both decrees are interlocutory; defendant could appeal from the first decree because it *granted* an injunction; complainant could not appeal from the second decree because it *refused* an injunction.

(2.) Complainant's appeal was taken on the theory that the second decree was *final* and would support an *independent* appeal; as the second decree was in fact interlocutory, not disposing of the entire litigation, the appeal on the theory that it was an independent appeal from a final decree was properly dismissed.

(3.) The main contention of the moving party before this court is that the two decrees constitute, in effect, one decree and that a cross appeal is therefore proper: but the second decree was entered *after* the appeal on the first decree and could not therefore alter or affect the rights of appeal based on the first decree.

But even though the subject matter of the two decrees were embraced in a *single* decree, the authorities relied upon do not support the moving party's position.

Smith vs. Vulcan Iron Works, 165 U. S., 518, was a case in which the patent was sustained as to *all* the claims in suit and injunction granted thereon. Upon appeal under sec. 7, of the Judiciary Act, the question arose as to whether the Court of Appeals was limited to a review of the pro-

priety of granting the injunction, whether improvident or not, or whether the court could go into the merits and consider also the question of validity and infringement and dismiss the bill if it found want of merits. It was held that the Court of Appeals had this authority.

In the present case the interlocutory decree of April 20, 1905, finds (1) validity and (2) infringement and (3) grants injunction as to claims 4 and 5 and contains no adverse finding as to the remaining claims in suit.

Therefore, under the doctrine of Smith *vs.* Vulcan Works, the Court of Appeals may consider the whole of this interlocutory decree and pass upon the validity and infringement of claims 4 and 5 as well as upon the propriety of granting the injunction.

But the moving party contends that Smith *vs.* Vulcan Works not only authorizes the Court of Appeals to pass upon the validity and infringement of the claims upon which an injunction is granted, but also, where the decree *refuses* an injunction as to other claims, to pass upon this question of *refusal* of injunction. This is an entirely different question from that presented in Smith *vs.* Vulcan Works. The Court of Appeals for the Seventh Circuit however, has interpreted Smith *vs.* Vulcan as authorizing such practice under certain conditions.

Chicago Co. vs. Miller Co. 133 Fed. Rep. 541 is the case in the Seventh Circuit. This case however, differs from the present case in two vital particulars.

(1.) In that case there was a *single* decree granting an injunction as to part of the claims and refusing an injunction as to the remainded; in this case there are *two* separate decrees, the second one, from which complainant appeals having been entered *after* the perfecting of the appeal on the first decree.

(2.) In that case defendant in perfecting its appeal from

the single decree brought up the *entire* record and *after* the entire record was before the appellate tribunal, complainant took a cross appeal; in the present case but a part of the record would have been taken up by defendant had the appeal by complainant not been taken. The patent exhibits and the evidence relating to claims 6, 7 and 8 were entirely different from those relating to claims 4 and 5 which were sustained and would not have been included in the record had not complainant appealed.

But even though the facts in the present case were the same as those in Chicago Co. *vs.* Miller Co., it is submitted that that case is not good law:

(1.) Because Smith *vs.* Vulcan Works is not authority for the doctrine set forth in Chicago Co. *vs.* Miller Co., and

(2.) Because Chicago Co. *vs.* Miller Co. is contrary to the express language of the Statute and the intent of Congress in enacting that Statute.

Smith *vs.* Vulcan Works is authority for the doctrine that where *all* of the claims in suit are sustained and an injunction is granted, the Court of Appeals has authority to consider the merits of the decree and pass upon the questions of validity and infringement as well as on the propriety of the injunction. It is not authority for the doctrine that where *part* of the claims are sustained and an injunction granted, while an injunction is *refused* as to the remaining claims, the Court of Appeals can pass upon the part refusing the injunction as well as upon the merits of the part granting the injunction.

Sec. 7, as originally enacted in 1891, was in the same form as at present, so far as the present issues are concerned; and granted an appeal where an injunction was granted but did not grant an appeal where an injunction was refused. A number of decisions were rendered holding that under this law the Court of Appeals would not

entertain a cross appeal by complainant to review that portion of the decree which refused the injunction.

In 1895 the section was amended evidently to avoid the effect of these decisions and the right was expresely granted to appeal from a decree refusing an injunction.

In 1900 the Act was again amended and the provision allowing appeal from a decree *refusing* an injunction was *striken out*, so that the Act now stands as it did in 1891, so far as present issues are concerned.

It was thus evidently the intent of Congress to re-establish the practice which had been fixed by the courts under the Act of 1891 and the language of the section is unequivocal.

It follows that the motion in both its aspects should be denied.

W. CLYDE JONES,
Attorney for Respondent.

JOHN RIDOUT,
Of Counsel.

SUPREME COURT OF THE UNITED STATES.

OCTOBER TERM, A. D. 1905.

NO. 18 ORIGINAL.

EX PARTE.

IN THE MATTER OF

AUTOMATIC SWITCH COMPANY OF BALTIMORE CITY,
Petitioner

BRIEF OF COUNSEL FOR THE CUTLER-HAMMER MFG. CO. IN OPPOSITION TO PETITION FOR WRIT OF MANDAMUS.

The Automatic Switch Company of Baltimore City, has been granted leave to file a petition for writ of mandamus and a rule has been entered upon the United States Circuit Court of Appeals for the Second Circuit, to show cause why a writ of mandamus should not issue, requiring that court to entertain an appeal of the Automatic Switch Company of Baltimore City prosecuted from a decree entered under date of May 26th, 1905, in a suit entitled *The Automatic Switch Co. of Baltimore City* v. *The Cutler-Hammer Mfg. Co.*

The return of the Circuit Court of Appeals has been made and filed before this court and this brief is presented in support of said return and in opposition to the petition for the writ of mandamus.

It is submitted in behalf of the return, that the writ of mandamus should not issue, and the rule should be discharged:

First, because under the circumstances of this case the issuance of the writ of mandamus is not the proper practice; and

Second, because on the merits the Circuit Court of Appeals did not err in dismissing complainant's appeal.

Statement of Facts.

The return of the judges of the Circuit Court of Appeals in response to the rule to show cause, sets forth fully the pertinent facts bearing upon the question of appeal involved herein.

The decision of the Hon. William K. Townsend, Circuit Judge, found claims 4 and 5 of the patent in suit to be valid and infringed and granted an injunction and an accounting with respect thereto and found claims 6, 7 and 8 not infringed.

April 20, 1905, the first decree was entered and filed; this decree found all of the claims in suit, 4, 5, 6, 7 and 8 valid, and found claims 4 and 5 infringed, and granted an injunction and an accounting with respect thereto. This first decree did not find the non-infringement of claims 6, 7 and 8, nor did it refuse an injunction or dismiss the bill of complaint with respect to claims 6, 7 and 8. The first decree found validity of claims 6, 7 and 8, but was silent as to the infringement thereof.

May 12th, 1905, defendant's appeal from the first decree dated April 20th, 1905 was allowed.

May 13th, 1905, citation was issued and served upon complainant.

May 26th 1905, the second or so-called "final" decree was entered and filed at the instance of complainant; this decree found non-infringement of claims 6, 7 and 8 and dismissed the bill of complaint with respect thereto.

June 7th, 1905, appeal by complainant was allowed from this second decree *after* defendant's appeal from the first decree had been perfected.

June 9th, 1905, the transcript of record containing documents specified by both parties in accordance with the rules was certified to by the clerk of the Circuit Court.

June 9th, 1905, the transcript of record was filed with the clerk of the Circuit Court of Appeals.

In view of the facts as above outlined and as set forth in the return certified to by the judges of the Circuit Court of Appeals, it will appear that the petition for the writ of mandamus and the brief in

support thereof are based on two misconceptions or misstatements as to the record and facts in this case.

(1) The petition and brief assume that the first interlocutory decree entered April 20, 1905, found claims 6, 7 and 8 *not infringed* (pages 3 and 10). As a matter of fact, however, the interlocutory decree of April 20, 1905, found claims 4, 5, 6, 7 and 8 valid and claims 4 and 5 infringed, but did not make any finding as to claims 6, 7 and 8 *with respect to infringement*. Nor did this first decree refuse an injunction or dismiss the bill of complaint as to claims 6, 7 and 8. This misconception or misstatement has an important bearing upon the petitioner's position, as will hereafter appear, since the authority upon which the petitioner principally relies is a case in which a *single* decree granted an injunction as to certain claims and refused an injunction as to other claims. In the present case there was one decree granting an injunction as to certain claims, from which an appeal was prosecuted, and *after* the appeal had been perfected, a *second* decree was entreed refusing an injunction as to other claims, from which second decree complainant prematurely undertook to prosecute an appeal.

(2) The petition and brief state that the *entire record* had been taken to the Court of Appeals by defendant *before* the appeal by complainant (pages 3, 4, 16, 17 and 19). As a matter of fact, at the date of complainant's appeal no transcript had been made up in the Circuit Court, nor had any transcript been filed in the Court of Appeals. After complainant's appeal, pursuant to the practice of the court requiring each party to pay one-half the expenses of the appeal, when both appeal, stipulation was made providing that each party should furnish the necessary copies of its printed record, the additional expenses to be paid half and half in accordance with the rules. A joint record was thereafter made up. At the date, therefore, of complainant's appeal, there was *not* a *complete* record taken up by defendant upon which a cross appeal could be based, or, in fact, any record.

I.

As to The Practice.

It is submitted that the writ of mandamus should not issue in the present case, because in view of the authorities we shall review the issuance of the writ is not warranted by the facts and circumstances of this case:

(1) Because the petitioner has another adequate remedy.

(2) Because the Supreme Court of the United States has neither original nor appellate jurisdiction of this cause; and

(3) Because the order sought to be reviewed by the writ of mandamus is an interlocutory order entered in the progress of the litigation and is not of that final and conclusive character which puts an end to the particular litigation and which alone warrants the issuance of the writ.

We shall consider these three grounds in the order above enumerated.

(1)

The writ of mandamus will not issue to correct the error of a subordinate tribunal unless there is no other adequate remedy.

Ex parte Newman, 14 Wall., 169.

In re Key, 189 U. S., 84.

In re Tampa Suburban R. R. Co., 168 U. S., 583.

In re Morrison, 147 U. S., 14, 26.

In re Pennsylvania Co., 137 U. S., 451, 453.

In re Key, supra, this court, by Justice Fuller, referring to the writ of mandamus, said:

> "It is not granted in doubtful cases, or where there is another adequate remedy, and whether it shall go or not usually rests in the sound discretion of the court."

In *Ex parte Newman, supra*, this court, by Justice Clifford, said:

> "Superior tribunals may, by mandamus, command an in-

ferior court to perform a legal duty where there is no other remedy."

In re Morrison, supra, this court, by Justice Blatchford, said (p. 26):

"In addition to this, a mandamus is never granted where the party asking it has another remedy."

In the present case, the complainant has an ample remedy. Complainant's appeal was based on the theory that the decree of May 26th, 1905, from which the so-called "cross appeal" was prosecuted, was a *final decree.* As a matter of fact, it was not a final decree because it merely dismissed the bill of complaint as to claims 6, 7 and 8, which were held not infringed, and thus did not dispose finally of the litigation before the court. At the date of the entry of this decree, the first decree granting an injunction as to claims 4 and 5 was pending on appeal before the Circuit Court of Appeals and the accounting as to claims 4 and 5 was pending before the Circuit Court.

Complainant's appeal was dismissed because it was *prematurely* taken. After the accounting and the entry of a *final* decree, complainant will have the right to prosecute an appeal to the Circuit Court of Appeals and can then have reviewed the question of infringement of claims 6, 7 and 8, which is the question sought to be prematurely reviewed by the appeal which has been dismissed.

It is thus apparent that the petitioner has an adequate, full and complete remedy by prosecuting an appeal after the entry of the final decree, and in view of this fact, it is submitted that the writ of mandamus should not issue.

(2)

The Supreme Court of the United States has neither original nor appellate jurisdiction of this cause and it cannot, therefore, grant the writ of mandamus.

In re Massachusetts, 197 U. S., 482.

In re Glaser, 198 U. S., 171.

In re Green, 141, U. S., 325.

In re Massachusetts, *supra*, this court, by Mr. Chief Justice Fuller, said (page 488):

> "And it has been repeatedly held as to the Circuit Courts, that they have no power under Sec. 716 to issue writs of prohibition and mandamus, except when necessary in the exercise of their existing jurisdiction. *Bath County* v. *Almy*, 13 Wall., 244. 248; *McClung* v. *Silliman*, 6 Wheat. 598, 601.
>
> "This is equally true of this court, that is to say, that in cases over which we possess neither original nor appellate jurisdiction we cannot grant prohibition or mandamus or certiorari as ancillary thereto.
>
> "*Rule discharged; petition denied.*"

In re Glaser, *supra*, this court, by Mr. Chief Justice Fuller, said (page 173):

> "In cases over which we possess neither original nor appellate jurisdiction, we cannot grant mandamus. Rev. Stat. Sec. 716; *In re Commonwealth of Massachusetts, Petitioner*, 197 U. S. 482.
>
> "Of course there is no pretense of original jurisdiction here, and since the passage of the act of March 3, 1891, 26 Stat. 826, c. 517, we have no jurisdiction to review the judgments or decrees of the District and Circuit Courts directly by appeal or writ of error in cases such as this case if pending in the Circuit Court.
>
> "*Rule discharged. Petition denied.*"

Since the passage of the Judiciary Act of March 30, 1891, referred to above, suits in equity for the infringement of letters patent, such as the present suit, are not reviewable by appeal or writ of error by the Supreme Court of the United States. Accordingly, the present case is in the same category as *in re Glaser supra*, and the writ of *mandamus* should not, it is submitted, be issued in aid of a cause of which this court possesses neither original or appellate jurisdiction.

(3)

The writ of mandamus cannot be used to correct judicial errors committed by an inferior court in the progress of a cause of which it accepts jurisdiction.

American Co. v. *Jacksonville Ry.*, 148 U. S., 372.
Ex parte Perry, 102 U. S., 183, 186.
Ex parte Schwab, 98 U. S., 240, 241.
Ex parte Whitney, 13 Peters, 404.

The writ of mandamus, when issued to require an appellate tribunal to entertain or reinstate an appeal dismissed for lack of jurisdiction, is issued only where the order, decree or judgment appealed from definitely and conclusively puts an end to the particular subject-matter in litigation and where the dismissal of the appeal puts it out of the power of the petitioner to take further action in the litigation.

See cases cited and relied upon by the petitioner and hereafter reviewed.

In the present case, the Circuit Court entertained jurisdiction and adjudicated the cause; two decrees were entered, one finding claims 4 and 5 infringed and granting an injunction and an accounting with respect thereto. Defendant appealed from this decree and the Circuit Court of Appeals has entertained this appeal and the appeal is now pending, and awaiting final hearing. After defendant's appeal, a second decree was entered dismissing the bill of complainant as to claims 6, 7 and 8, found not infringed. Complainant prosecuted a separate and independent appeal from this decree. An *interlocutory order* has been entered by the Circuit Court of Appeals dismissing this second appeal for lack of jurisdiction. The appeal was taken by complainant on the mistaken assumption that it was a final decree. The appeal was dismissed because premature. Complainant will have an opportunity to present the same subject-matter to the Court of Appeals upon appeal from the final decree when entered. The interlocutory order dismissing the appeal is, therefore, merely an order entered during

the progress of a cause of which the Court of Appeals has entertained jurisdiction.

The order dismissing complainant's appeal does not therefore put *the cause* out of court, but merely removes from the present consideration of the Court of Appeals the question of the infringement of claims 6 and 7, which was involved in complainant's appeal.

In *Ex parte Perry, supra*, this court, by Mr. Chief Justice Waite, said (page 186):

> "We cannot by *mandamus* correct the judicial errors committed by an inferior court *in the progress of a cause*. *Ex parte Schwab*, 98 U. S. 240. We can in this way, in a proper case, compel an inferior court to act, but cannot control its decisions while acting. In the present case it appears that the Circuit Court has acted on the motion of the petitioner, and denied him what he asked. The object of this proceeding is to obtain from us an order requiring that court to reverse its former decision and grant the relief it has once refused. That is the office of a writ of error or an appeal, and not of a writ of *mandamus*. *Ex parte Flippin*, 94 U. S., 248; *Ex parte Loring*, id. 418. Neither is the case changed because the appropriate remedy may involve an inconvenient delay. In *Ex parte Whitney* (13 Pet. 404), it was held that a writ of *mandamus* ought not to be used to correct orders made by a judge in the exercise of his authority, even though such orders 'may seem to bear harshly or oppressively upon the party' complainant.
>
> "*Mandamus refused.*" (Italics ours.)

The appropriate remedy in the present case is an appeal after the entry of the final decree. Complainant's objection to this remedy is that it will cause an inconvenient delay, but in view of the above decision, such inconvenient delay cannot authorize the issuance of the writ. The Circuit Court of Appeals has entertained the cause on appeal, and has merely entered an interlocutory order dismissing *part* of the subject-matter from the present appeal because it is premature and does not properly arise for adjudication until after the entry of the final decree. Even though the delay until the final decree may seem to bear harshly or oppressively

upon the petitioner, this fact cannot warrant the issuance of the writ.

In *Ex parte Schwab, supra*, this court, by Mr. Chief Justice Waite, said:

> "When the application was made for the allowance of the injunction, it became the duty of the court to determine whether the case was one in which that power could be exercised. The question arose in the *regular progress of the cause*, and, if decided wrong, an error was committed, which, like other errors, may be corrected on appeal *after final decree below*.
>
> "The case is entirely different from what it would have been if the *only* object of the suit had been to enjoin Schwab from proceeding in the State court. There the question would have been as to the jurisdiction of the Circuit Court *over the cause*. But here is clearly jurisdiction *of the cause*. The assignee in bankruptcy had the undoubted right to sue Schwab in the Circuit Court to settle the title to the goods or the fund arising from their sale. The injunction was *a mere incident* to the *principal* relief he asked. *Even if not granted, the suit could go on.*
>
> "Being satisfied, by the petitioner's own showing, that the error, if any, in the court below cannot be corrected by mandamus, we deny the motion for an order to show cause.
>
> "*Motion denied.*" (Italics ours.)

Likewise, in the present case, the question as to the allowance of the appeal relating to the question of infringement of claims 6 and 7, arose in the regular progress of the cause, and if the Court of Appeals was in error in dismissing this partial appeal, the error can be corrected after the final decree below.

In the present case there is no question as to the jurisdiction of the Circuit Court of Appeals *over the cause* and the question of the second appeal was a mere incident to the principal relief asked. "Even if not granted, the suit could go on."

In *American Co.* v. *Jacksonville Ry. Co., supra*, this court, by Mr. Justice Gray, said (p. 379):

> "Least of all can a writ of mandamus be granted to review a ruling or *interlocutory order* made in the progress of a cause; for, as observed by Chief Justice Marshall, to do this 'would

> be a plain evasion of the provision of the act of Congress that final judgments only should be brought before this court for re-examination;' would 'introduce the supervising power of this court into a cause while depending in an inferior court, and prematurely to decide it;' would allow an appeal or writ of error upon the same question to be 'repeated, to the great oppression of the parties;' and 'would subvert our whole system of jurisprudence.' *Bank of Columbia* v. *Sweeny*, 1 Pet. 567, 569; *Life & Fire Ins. Co.* v. *Adams*, 9 Pet., 573, 602." (Italics ours.)

In *Ex parte Whitney, supra*, this court, by Mr. Justice Story (p. 408), said:

> "The district Judge *is proceeding in the cause*, however irregular that proceeding may be deemed; and the appropriate redress, if any, is to be obtained by *an appeal after the final decree* shall be had in the cause. A writ of mandamus is not the appropriate remedy for any orders which may be made in a cause by a judge in the exercise of his authority; although they may seem to bear harshly or oppressively upon the party. The remedy in such cases must be sought in some other form." (Italics ours.)

The Petitioner's Authorities. In each of the cases cited in the petitioner's brief in support of the issuance of the writ of mandamus, the order, judgment or decree appealed from definitely and without recourse put an end to the particular subject-matter in litigation, or to the litigation against the particular defendant, so that further action of the petitioner was effectually blocked unless by the issuance of the writ of mandamus.

In the present cause, the dismissal of complainant's cross appeal does not put an end to the litigation or block the petitioner's further progress in the litigation. On the contrary, the litigation proceeds to adjudication by the Court of Appeals as to the propriety of granting the injunction as to claims 4 and 5, and the accounting proceeds before the Circuit Court as to claims 4 and 5, and the cause proceeds to the eventual entry of a final decree and to the review of all questions (including the one sought to be raised by the second appeal) upon appeal from the final decree.

The interlocutory order dismissing complainant's cross-appeal is

therefore not such an order as effectually puts an end to the litigation and calls for the issuance of the writ of mandamus.

We shall now review briefly the several authorities relied upon by the petitioner and show that in each case the erroneous order, judgment or decree which was corrected by the issuance of the writ of mandamus, would, had it not been corrected, have completely blocked any further action by the petitioner and would have put an end to the particular litigation concerned.

Insurance Co. vs. Comstock, 16 Wall., 258. A final judgment was entered in this case after trial by jury and verdict. A writ of error was prosecuted which was dismissed for want of jurisdiction. The writ of mandamus was issued to correct the error. This was a case in which the decree was final, so that the dismissal of the writ of error effectually put an end to the litigation, and the petitioner had no other remedy had the writ not issued. This case is clearly not an authority in support of the present petition, which undertakes (1) to review an *interlocutory order* dismissing an appeal as to *a part* of the subject-matter in litigation; (2) in a cause in which the Supreme Court does not have appellate jurisdiction; and (3) in which complainant has an adequate remedy by the prosecution of an appeal after the entry of the final decree.

Vigo's case, 21 Wall., 648. This was an action in the court of claims against the United States. After the entry of final judgment, the United States asked the allowance of an appeal to the Supreme Court, which was refused. Application was made for writ of mandamus to compel the allowance of the appeal, which was granted. This was a case in which the refusal of the appeal put an end to the litigation, and put it beyond the power of the petitioner to take any further action in the establishment of its rights.

Railroad Co. vs. Wiswall, 23 Wall., 507. The petitioner sued in one of the state courts of Illinois. Defendant secured an order from the Circuit Court of the United States for that district for the removal of the cause to that court. The Circuit Court, upon looking further into the matter, was satisfied that it had no jurisdiction and remanded the case to the state court, thus putting

it effectually out of the power of the petitioner to proceed further in the federal courts without the aid of the writ of mandamus. This was not a final judgment or decree after a full hearing upon the merits, such that, an appeal or writ of error could be prosecuted, although it was a final judgment definitely barring the petitioner from further proceedings in the federal courts. Accordingly, the writ of mandamus issued.

Ex parte Jordan, 94 U. S., 248. In this case certain interlocutory orders were entered during the progress of the cause and after the entry of a final decree the allowance of an appeal was requested for the purpose of reviewing the correctness of the interlocutory orders as well as some of the findings of the final decree, but was refused. The writ of mandamus was requested and issued. Although some of the errors complained of related to the interlocutory orders, the appeal from the final decree was properly taken and under such an appeal the errors in the entry of the interlocutory orders could be reviewed. The court further held that the petitioner was not estopped from questioning the provisions of the final decree which had been appealed from. This, therefore, was a case in which the refusal of the appeal ended the litigation and put it out of the power of the petitioner to further assert his rights.

Ex parte Railroad Co., 95 U. S., 221. In this case a bill was filed against a number of defendants. A cross-bill was filed by the Alabama Company, one of the defendants. This cross-bill was disposed of by special interlocutory decree, and at the termination of all the litigation a final decree was entered. The Alabama Co. thereupon prayed an appeal, which was refused. A writ of mandamus was thereupon prayed. This court held, in effect, as we understand the decision, that although the special decree disposing of the cross-bill was interlocutory, this decree could be reviewed upon an appeal from the final decree, and that, accordingly, the appeal of the Alabama Co. should have been allowed.

The writ of mandamus was accordingly issued. This was a case where the refusal of the appeal put the Alabama Co. out of court and ended the controversy and the petitioner had no recourse except

through the writ of mandamus. The allowance of the appeal was requested after the entry of the final decree settling all matters in dispute in the litigation.

Ex parte Parker, 120 U. S., 737. In this case a final decree was entered against the two defendants severally and an appeal was taken by the defendant Parker. The appeal was from the District Court of Washington Territory to the Supreme Court of Washington Territory; and this appeal having been dismissid, the writ of mandamus was sought to require its reinstatement. The dismissal was on the ground that one of the co-defendants could not individually appeal. The dismissal of the appeal effectually put it out of the power of the petitioner to continue the litigation or protect his rights. The writ of mandamus was accordingly issued. The decree appealed from was final and the dismissal of the appeal effectually put an end to the litigation, so far as the petitioner was concerned.

Hollard Parker, 131 U. S., 221. In this case a final judgment was entered after trial by jury and verdict. An appeal from the judgment thus entered by the District Court of the Territory of Washington was taken to the Supreme Court of the Territory, and this appeal was dismissed on the ground that no assignment of errors had been properly filed and served on the opposite party. The writ of mandamus was sought to compel the reinstatement of the appeal and was granted. This was a case in which the dismissal of the appeal finally ended the litigation and put it out of the power of the petitioner to proceed further without the aid of the writ of mandamus.

Ex parte Hohorst, 150 U. S., 653. This was a suit for infringement against a number of parties, one being a corporation. The appeal was dismissed against the corporation on the ground that the service was defective. From this order the complainant took an appeal to the Supreme Court of the United States and this appeal was dismissed for want of jurisdiction. Writ of mandamus was then sought to compel the Circuit Court to take jurisdiction as against the company on the ground that the service was not

defective. The writ of mandamus was granted. In this case the order dismissing as to the corporation, while not being a final decree putting an end to all of the litigation from which an appeal could be taken, was an order which finally ended the litigation and put a stop to it, so far as the corporation defendant was concerned. The petitioner was without further recourse against the corporation defendant in the litigation unless by writ of mandamus.

Matter of Christensen Co., 194 U. S., 458. In this case a preliminary injunction was granted against the infringement of a patent. Subsequent to the grant of the injunction and prior to the final decree, defendant was adjudged guilty of contempt for violation of the injunction. A writ of error was sued out to review the order adjudging contempt. This writ of error was dismissed by the Court of Appeals for want of jurisdiction and the writ of mandamus was sought to require the reinstatement of the writ of error. The question to be decided was whether the contempt order was an interlocutory or a final adjudication. If the fine was compensatory, it was undoubtedly ancillary to the infringement suit. If the fine was punitive, the contempt order had an independent standing, and was of such a final character as to warrant an appeal independently of the appeal in the infringement suit. This court held, as we read the decision, that in view of the fact that one-half of the fine went to the United States, it was punitive. Accordingly, the contempt order was not an interlocutory order in the infringement suit, but was of such an independent character that an independent appeal was proper. Accordingly, the writ of mandamus was issued to compel the reinstatement of the appeal.

This decision is authority for the proposition that the writ of mandamus is *not* proper to require the reinstatement of a dismissed appeal from an *interlocutory* order and in line with *American Co.* v. *Jacksonville Co., supra,* It is clear from the reasoning of the court that had it found that the fine was compensatory instead of punitive, the contempt order would have been an *interlocutory* order and the writ of mandamus would have been refused. This decision is, therefore, directly opposed to the practice

which the petitioner in the present cause is attempting to establish, permitting the use of the writ of mandamus to compel the reinstatement of a partial appeal which was dismissed as premature by an *interlocutory order* made during the progress of a cause of which the Court of Appeals has assumed jurisdiction.

The above review of the authorities submitted by the petitioner in support of its position shows conclusively that in *not one* was the writ of mandamus issued to aid an appeal from an *interlocutory order*, but that in *every case* the order, judgment or decree from which an appeal was sought, and in aid of which appeal the writ of mandamus was issued, was of such *final and conclusive character* that the refusal or dismissal of the appeal effectually ended the litigation, as a whole, or as to the particular litigant in question.

In the present cause, the order is purely interlocutory in character, dismissing an appeal from *a part only* of the subject-matter in litigation, while entertaining an appeal as to the remainder of the subject-matter, and merely requiring the petitioner to wait until a later stage in the litigation and until after the entry of a final decree before prosecuting an appeal as to the particular subject-matter in question.

In view of the above, it is respectfully submitted that the writ of mandamus should not issue in the present case:

(1) Because the petitioner has another adequate remedy and the issuance of the writ of mandamus is not essential in order that the litigation may proceed to a full determination.

(2) Because this is a patent cause of which this court does not have appellate jurisdiction and, accordingly, is without authority to issue the writ of mandamus in aid of the proceedings therein; and

(3) Because the order dismissing complainant's cross-appeal is a purely interlocutory order made in the progress of the litigation and is not of such final and conclusive character as to warrant the issuance of the writ of mandamus.

II.
As to The Merits.

But even though the issuance of the writ of mandamus were proper to correct an error in the dismissal of an appeal like that before the court, it is submitted that the dismissal was proper under the law and the authorities and that the writ of mandamus should be denied for this reason.

Three theories as to the nature of the two decrees have been presented by the opposing parties.

(1) It is the position of The Cutler-Hammer Mfg. Co., defendant, that the decrees of April 20th, 1905, and May 26, 1905, are both interlocutory decrees.

(2) It was the main contention of the petitioner at the argument of the motion to dismiss the cross-appeal that the first decree was interlocutory, while the second decree was final.

(3) It appears to be the main contention of the petitioner herein that both decrees are interlocutory but constitute, in effect, a single decree.

It is submitted that the first of the above theories is the only one which is tenable, but that under any aspect of the matter, the dismissal of complainant's appeal was proper in view of the law and authorities.

A.

We submit the following controlling propositions, which are established by the authorities and the record in this case.

(1) **The first decree entered April 20th, 1905, is interlocutory.** This fact is not disputed. The decree

> "Adjudged, ordered and decreed . . . that the said letters patent No. 499,769, granted June 20, 1893, to George Herbet Whittingham, as to claims 4, 5, 6, 7 and 8 thereof, are good and valid in law and that the defendant . . . has infringed upon claims 4 and 5 of said letters patent."

The decree granted an injunction and an accounting as to claims 4 and 5.

This decree granting a perpetual injunction but reserving an accounting is interlocutory and not final.

Smith v. *Vulcan Iron Works,* 165 U. S., 518, 524.
Keystone Co. v. *Martin,* 132 U. S., 91.
Crawford v. *Points,* 13 How., 11.
Barnard v. *Gibson,* 7 How., 650.
Humiston v. *Stainthorpe,* 2 Wall., 106.

(2) **The second decree entered May 24th, 1905, is interlocutory and not final.** This decree

> "Adjudged, ordered and decreed that the bill of complaint herein be, and the same hereby is dismissed as to claims 6, 7 and 8 of the Whittingham patent here in suit, as not being infringed by defendant."

This decree still left before the Circuit Court the accounting on claims 4 and 5, the control of the injunction which, upon motion, had been suspended by the Circuit Court, and the carrying out of the mandate of the Court of Appeals after its decision of the appeal from the first interlocutory decree, which appeal, on May 24th, 1905, had already been perfected and was pending before the Court of Appeals.

A decree which does not finally dispose of all the subject-matter in litigation is not a final decree, from which an appeal can be taken.

Keystone Co. v. *Martin,* 132 U. S., 91.
Crawford v. *Points,* 13 How., 11.
Barnard v. *Gibson,* 7 How., 650.
Humiston v. *Stainthorpe,* 2 Wall., 106.
Smith v. *Vulcan Works,* 165 U. S., 518.
Marden v. *Campbell,* 67 Fed. Rep., 811.

In **Keystone Co. v. Martin,** *supra,* this court said (p. 93):

> "We think that the decree is not a final decree, and that this court has no jurisdiction of the appeal. The decree is not final, because it does not dispose of the entire controversy between the parties. The bill prays only for an injunction and an account of the quantity and value of the ore taken from the land by the defendant. The injunction is granted, but the account remains to be taken. The case is not one where nothing remains to be done by the Court below, except to execute ministerially

its decree. In all cases like the one before us this Court has uniformly held that the decree was not final and was not appealable."

The court then discusses a number of authorities, among them:

Barnard v. Gibson, *supra.*

"In *Barnard* v. *Gibson,* the suit was one for the infringement of letters patent. By the decree of the Circuit Court a perpetual injunction was awarded, and it was referred to a master to ascertain and report the damages which the plaintiff had sustained. It was held that the decree was not appealable. The decree in that case was in all substantial particulars like the decree in the present case."

In **Humiston v. Stainthorpe,** *supra,* it was held that a decree in chancery awarding to a patentee a permanent injunction and an accounting of gains and profits is not a final decree from which an appeal can be taken.

In **Crawford v. Points,** *supra,* it was held that a decree which settled certain rights to property, but reserved an accounting of rents and profits was not a final decree from which an appeal would lie.

In **Smith v. Vulcan Works,** *supra,* it was held that a decree in a patent cause granting an injunction and referring the cause to a master for an accounting, was interlocutory and not final, and therefore not receivable on appeal before the final decree in the cause.

The above authorities clearly establish the principle that a decree such as the second decree entered in the present case under date of May 24th, 1905, is not a final decree because it does not finally dispose of all the subject-matter in litigation.

Petitioner's Authorities.—The petitioner, however, relies upon several authorities in support of its position that the second decree was final, and we shall now briefly analyze these authorities to show that neither supports the petitioner's contention.

Forgay v. Conrad, 5 How., 201, relied upon by the petitioner, was an exceptional case. The decree directed the defendant to pay a certain sum of money to the complainant, and the complainant

was entitled to have such decree *carried immediately into execution,* and under these exceptional circumstances the court held that an appeal would lie as from a final decree, notwithstanding there was an item of account to be adjusted. This case is analyzed and distinguished in **Keystone Iron Co. v. Martin,** 132 U. S., 91, 97, and its limited application pointed out; it is clear that the exceptional circumstances of that case are not present in the case now before this court.

The peculiar and exceptional character of the circumstances in *Forgay* v. *Conrad* is likewise discussed by this court in **Barnard v. Gibson,** 7 How., 650, 657, and this court said:

> "The decree in that case would have been executed by a sale of the property and the proceeds distributed among the creditors of the bankrupt and lost to the appellants, before the minor matters of account referred to the master could be adjusted and acted on by the court. The course of procedure in the Circuit Court was irregular, and the consequent injury to the defendants would have been irreparable."

This court thus makes it clear that *Forgay* v. *Conrad* was not intended as a departure in any manner from the uniform course of decisions of this court, holding that an appeal may be prosecuted only from a final decree, which puts an end to all of the subject-matter in litigation.

Hill v. Chicago Railroad Co., 140 U. S. 52, is another case referred to by the petitioner in support of its contention that the second decree is final. This case was also exceptional and does not alter the general law to the effect that the decree from which an appeal can be taken must be a final decree. In this case a final decree was entered disposing of every ground of contention between the parties, but referring to a master the ascertainment of the amount of one item which was separable from the other matters in controversy, and which concerned only a part of the defendants. This decree was held to be a final decree.

This court, in **Hohorst v. Hamburg-American Packet Co.,** 148 U. S., 262, 266, held that a decree dismissing the bill of complaint as to one of the several defendants was not a final decree as

to such defendant, which would sustain an appeal; and in that decision this court considered *Hill* v. *Chicago Railroad Co.*, and distinguished therefrom as follows:

> "There are cases in equity in which a decree disposing of every ground of contention between the parties, except as to the ascertainment of an amount in a matter separable from the other subjects of controversy, and relating only to some of the defendants, may be treated as final, though retained for the determination of such severable matter. *Hill* v. *Chicago & Evanston R. R.*, 140 U. S., 52. But this case presents no such aspect. Complainant insisted by his amended bill that the alleged liability was *joint*, and that 'all the defendants have co-operated and participated in all the said acts and infringement'."

Likewise, in the present case there is no severability between the subject-matter of claims 4 and 5 of the patent upon which an injunction was granted and the subject-matter of claims 6, 7 and 8, upon which the injunction was refused. These are all claims of a single patent, and the one device made by defendant was alleged in the bill of complaint to infringe all of the claims. The infringement alleged was joint. Accordingly, the feature of severability being absent, *Hill* v. *Chicago R. R. Co.* is not an authority for the petitioner's position.

This court, **in re Hohorst,** 150 U. S., 653, 657, again held that a decree not disposing of the litigation as to *all* the defendants, was not a final decree from which an appeal would lie.

Scriven v. North, 134 Fed. Rep., 366, is likewise not an authority for the petitioner's position. The bill of complaint in this case consolidated in one suit four separate and distinct causes of action: (1) patent infringement; (2) trade-mark infringement; (3) unfair copying of goods; and (4) unfair dressing of goods.

Courts of equity have uniformly permitted the joining of several distinct causes of action in one bill of complaint where the same act by defendant gives rise to the several causes of action, and where there is no diversity of defendants with respect to the several causes of action. Accordingly, such causes of action are severable. The decree in this case entered after a hearing on full proofs related to these four separate causes of action. As to all but the latter, the

bill was dismissed. The appeal was not taken under Section 7, as from an interlocutory decree, but was taken under Section 6, as from a final decree; the appeal was entertained, the court holding that the situation was exceptional and within the ruling of *Forgay* v. *Conrad*. The decree was held to be final, however, solely because of the separability of the several causes of action, which separability is entirely absent in the case now before the court.

In view of the authorities above discussed, it is clear that the second decree in this case, entered on May 26th, 1905, is an interlocutory decree and not a final decree. It does not dispose of the entire subject-matter in litigation, nor is the subject-matter of which it disposes severable from the remainder of the litigation; nor did it dispose of all subject-matter then remaining before the Circuit Court, because that court retained the accounting, which was not stayed by the appeal, the control of the injunction which had been suspended, and the court was subject to the mandate of the Court of Appeals upon the decision of defendant's appeal from the first decree granting an injunction as to claims 4 and 5.

In **Marden v. Campbell,** 67 Fed. Rep., 811, the court clearly points out that there cannot be two final decrees in a patent cause.

> "The settled practice of the supreme court touching appeals and writs of error is such as to prevent the same case reaching it a multiplicity of times, so far as practicable to accomplish this; and, moreover, by the settled modes of proceedings in equity in a cause of this kind, although there may be an interlocutory finding declaring certain claims void and others valid, yet there is only one final decree. It would be contrary to all well-conceived notions to imagine two final decrees in a patent cause of this character. The proposition of the complainant below in this direction cannot be entertained."

(3) **Defendant appealed May 12th, 1905, under Sec. 7 of the Judiciary Act of 1891, before the second decree was entered.** Defendant's appeal was taken under the authority granted by said section 7, allowing an appeal from an interlocutory order or decree *granting* an injunction; the first decree granted an injunction as to claims 4 and 5, and this decree was therefore appealable without waiting for the entry of the final decree.

The subsequent entry of the second decree after defendant's appeal had been perfected, cannot, therefore, affect or enlarge the rights of appeal based upon the first decree.

(4) **Complainant appealed June 7th, 1905, from the second decree entered May 24th, 1905.** This was an *independent* appeal from a supposed final decree, and not a cross-appeal. It was taken under Section 6 of the Judiciary Act of 1891, granting appeals from *final* decrees.

That complainant's appeal was taken as an independent appeal clearly appears from complainant's brief before the Circuit Court of Appeals in opposition to the motion to dismiss, from which we quote as follows:

> "The litigation as to claims 6, 7 and 8 remaining thus undisposed of by any order or decree on May 26th, 1905, there was entered a final decree as to claims 6, 7 and 8. And *this* is the decree from which we appeal. We appeal from it as from a *final* decree, under the reasoning and authority of *Scriven* v. *North*, 134 F. R., 366, 368, and cases cited. *Forgay* v. *Conrad*, 47 U. S., 250; *Potter* v. *Beal*, 50 F. R., 860."

In view of this statement in complainant's brief, there can be no question but that the appeal of complainant, which has been referred to as a cross-appeal, was taken as an independent appeal from a decree, supposed to be a final decree, under Section 6 of the Judiciary Act.

(5) **Complainant's appeal cannot be sustained as an independent appeal from a final decree,** because the second decree was an interlocutory decree, since it did not dispose of the entire litigation. Not being a final decree an independent appeal therefrom, under Section 6 of the Judiciary Act, was not authorized.

(6) **Complainant's appeal cannot be sustained as an independent appeal from an interlocutory decree,** since the second decree of May 24th, 1905, appealed from, *refused* an injunction and is, therefore, not appealable under Section 7.

(7) **Complainant's appeal cannot be sustained as a cross-appeal from the first interlocutory decree dated April 20th, 1905,** from which decree defendant appealed, because that

decree is wholly *in favor of complainant* and is *not adverse in any particular*. Accordingly, complainant cannot prosecute a cross-appeal or assign cross-errors based upon the first interlocutory decree, because a party cannot appeal from a decree which is wholly in his favor.

(8) **Complainant's appeal cannot be sustained as a cross-appeal based on the subsequent decree of May 24th, 1905,** because that decree was entered *after* the appeal had been perfected by defendant from the first interlocutory decree. Manifestly, after defendant's appeal from the first interlocutory decree had been perfected, May 12th, 1905, the Circuit Court lost jurisdiction of that decree and no action which complainant could take in the Circuit Court by the entry of a decree after that date could enlarge the rights of appeal based upon the first decree. There was nothing adverse to complainant in the first decree, so that a cross-appeal could not be based on that decre alone, and clearly no decree or order that might *thereafter* be entered by the Circuit Court could give to complainant any rights of cross-appeal in the Court of Appeals not based upon the first decree.

(9) **The two decrees cannot for the purpose of appeal be considered as one decree,** because the Circuit Court had lost jurisdiction of the first decree by defendant's appeal *before* the second decree was entered. Defendant perfected its appeal from the first decree, May 12th, 1905, and it was *after* this date, and on May 24th, 1905, that the second decree was entered, from which complainant appealed on June 7th, 1905. At the date, therefore, when the second decree was entered, the Circuit Court had lost jurisdiction of the first decree. The second decree, therefore, cannot be considered in any sense an *amendment* of the first decree, because the Circuit Court had lost jurisdiction of the first decree, and nothing which it could do at that time could in any manner alter the rights of defendant in its appeal from the first decree then pending before the Court of Appeals. Complainant's principal contention before this court is that the two decrees may be considered as constituting one decree, granting an injunction as to certain claims and refusing the injunction as to other claims, and that complainant by virtue of

its appeal can have reviewed the propriety of the refusal of the injunction. The facts in the present case, however, are very different from what they would have been had a *single* decree granting the injunction as to some of the claims and refusing the injunction as to other claims been entered *before* defendant's appeal. In the present case defendant's appeal intervened between the first and the second decrees and irrevocably separates them into two distinct decrees, which must, so far as the rights of appeal are concerned, stand each on its own base.

(10) **At the date of complainant's appeal defendant had not taken up a complete record,** or, in fact, any record; after both appeals had been taken, a joint record was made up; therefore, at the date of complainant's appeal there was no complete record before the Court of Appeals upon which a cross-appeal could be based.

B.

In view of the above propositions, it is apparent that the first of the three theories as to the nature of the two decrees is the only one which is tenable.

(1) Both decrees are interlocutory; defendant could appeal from the first decree because *it granted an injunction;* complainant could not appeal from the second decree because *it refused an injunction.*

(2) Complainant's appeal was taken on the theory that the second decree was *final* and would support an *independent* appeal; as the second decree was in fact interlocutory, not disposing of the entire litigation, the appeal, on the theory that it was an independent appeal from a final decree under Section 6 of the Judiciary Act, was properly dismissed.

(3) The main contention of the petitioner before this court is that the two decrees constitute, in effect, one decree, and that the appeal of complainant may, therefore, properly be considered as a cross-appeal; but the second decree was entered *after* the appeal on the first decree and could not therefore alter or affect the rights of appeal based on the first decree. Any right to a cross-appeal must be

based upon the first decree, from which defendant's appeal was taken; this decree was not adverse to complainant in any particular and the cross-appeal, therefore, would not lie.

But even though the subject-matter of the two decrees were embraced in a *single* decree, the authorities relied upon do not support the petitioner's position.

Smith v. Vulcan Iron Works, 165 U. S., 518, upon which the petitioner principally relies, was a case in which the patent was sustained as to *all* the claims in suit, and an injunction granted thereon. Upon appeal from this decree as an interlocutory decree, under Sec. 7 of the Judiciary Act, the question arose as to whether the Court of Appeals was limited to a review of the propriety of granting the injunction, whether improvident or not, or whether the court could go into the merits and consider also the question of validity and infringement and dismiss the bill if it found want of merits. It was held that the Court of Appeals had this authority. That is, on an appeal from an interlocutory decree granting an injunction, the Court of Appeals may consider:

(1) The propriety of granting the injunction;

(2) The validity of the claims; and

(3) The question of infringement.

If, in the opinion of the Court of Appeals, validity or infringement is not established, the bill may be dismised for want of merits.

In the present case, the interlocutory decree of April 20, 1905, finds:

(1) Validity;

(2) Infringement; and

(3) Grants an injunction as to claims 4 and 5, and contains no adverse finding as to the remaining claims in suit.

Therefore, under the doctrine of *Smith* v. *Vulcan Works*, the Court of Appeals may, upon defendant's appeal from this interlocutory decree, consider the *whole* of this interlocutory decree and pass upon the validity and infringement of claims 4 and 5, as well as upon the propriety of granting the injunction.

But the petitioner contends that *Smith* v. *Vulcan Works* not only

authorizes the Court of Appeals to pass upon the validity and infringement of the claims *upon which an injunction is granted,* but also where the decree *refuses* an injunction as to other claims, to pass upon this question of *refusal* of injunction. This is an entirely different question from that presented in *Smith* v. *Vulcan Works.* Moreover, this is a question which does not arise on the facts in the case now before this court, because here there is not a *single* decree granting an injunction as to some claims and *refusing* an injunction as to other claims. On the contrary, the first decree from which defendant has appealed and which appeal is now pending before the Court of Appeals, does *not* refuse an injunction as to any of the claims. The refusal of the injunction is embraced in the *second* interlocutory decree, entered May 24th, 1905, *after* defendant had perfected its appeal from the first decree.

But even though there was a single decree in the present case, both granting and refusing an injunction, it is submitted that *Smith* v. *Vulcan Works* is not authority for the Court of Appeals to pass upon the *refusal* of the injunction upon an appeal by the complainant under Sec. 7 of the Judiciary Act. On the contrary, we submit that under such circumstances, which are purely hypothetical, since they do not exist in this case, an appeal by the complainant from the portion of such a decree refusing the injunction, is expressly precluded by the clear language of the act itself.

It is clear that *Smith* v. *Vulcan Iron Works,* relied upon by complainant, does not decide the precise point which the petitioner is now attempting to establish.

C.

The Circuit Courts of Appeal, however, of most of the circuits have clearly announced the doctrine that where under Section 7 an appeal is taken from an interlocutory decree which both grants and refuses an injunction, the Circuit Court of Appeals will limit its review to that portion of the decree which grants the injunction, and will refuse to entertain an appeal or a cross-appeal from that portion of the decree which *refuses* an injunction.

The leading cases in the several circuits establishing this doctrine are as follows:

Second Circuit.

Thomson-Houston Co. v. *Nassau Co.*, 112 Fed. Rep., 676.

Kilmer Mfg. Co. v. *Griswold*, 67 Fed. Rep., 1017.

Eagle Lock Co. v. *Corbin Cabinet Lock Co.*, 64 Fed. Rep., 789.

Westinghouse Co. v. *Christenson Co.*, 104 Fed. Rep., 622.

First Circuit.

Marden v. *Campbell Co.*, 67 Fed. Rep., 809.

National Co. v. *Automatic Co.*, 105 Fed. Rep., 670.

Sixth Circuit.

Western Electric Co. v. *Abbott*, 108 Fed. Rep., 953.

Seventh Circuit.

Columbia Wire Co. v. *Boyce*, 104 Fed. Rep., 172.

Ninth Circuit.

Frye & Bruhn v. *Carstens*, 130 Fed. Rep., 766.

Thomson-Houston Co. v. Nassau Co., *supra*, was decided Dec. 9th, 1901. In this case a *single* decree was entered after final hearing, finding infringement of five claims, non-infringement of five claims and invalidity of two claims. A perpetual injunction and an accounting were granted as to the five claims held infringed, and the bill was dismissed as to the remaining seven claims. Complainant's appeal from the refusal of the injunction as to the seven dismissed claims was dismissed on motion.

Kilmer v. Griswold, *supra*, was decided April 23rd, 1895, while the original Act of 1891 was in force. Two patents were in suit; one patent was held infringed, and an injunction and accounting awarded, while the bill was dismissed as to the other patent. A single interlocutory decree was entered, from which both parties appealed. The court said:

> "Inasmuch as the decree of the Circuit Court is not final, the only appeal which can be considered is from so much of such decree as grants an injunction."

Eagle Lock Co. v. Corbin Cabinet Lock Co., *supra*, was decided December 3, 1894. After final hearing, one of the claims in

suit was sustained and a perpetual injunction and an accounting awarded, and the bill was dismissed as to the remainder of the claims in suit. From that part of the interlocutory decree which related to the claims sustained, an appeal was taken by defendant. This court said (p. 790):

> "As infringement is practically admitted, the validity of this claim is the only question before this court. The correctness of the other conclusions of the Circuit Court has not been considered, as the decree was not a final one."

That is, the court refused to consider the correctness of that portion of the interlocutory decree which dismissed the bill as to certain of the claims. The court thus limited its review to the claims upon which the injunction was granted.

Westinghouse Co. v. Christenson Co., *supra,* decided Oct. 24, 1900, after the amendment of 1900, was a case in which an interlocutory order was entered denying a preliminary injunction, and the Court of Appeals held that no appeal would lie from an order refusing an injunction.

Marden Mfg. Co. v. Campbell Co., *supra,* decided May 4, 1895, under the original act of 1891, was a case in which a decree was entered granting an injunction as to certain claims and refusing an injunction as to other claims. Defendant moved to dismiss the cross-appeal by complainant. The court analyzed the statute and the reasons for its enactment, and held that the statute permitted a defendant to obtain a speedy appeal when under injunction, but did not warrant the court to review that portion of the decree which refused an injunction. It was contended:

> "that so much of the decree below as adjudged certain claims invalid or not infringed, was final and entitled the complainant to an appeal independently of the second section of the Act of Mar. 3, 1891."

This is precisely the contention which is made by the petitioner herein with respect to the second decree, which refused an injunction as to claims 6, 7 and 8.

The court said:

> "On the contrary, the practice has been so continuous for

so long a time the other way, and with such universal acquiescence, that this proposition so far as we know has never been made nor any necessity arisen for its adjudication. This long continued recognition of the rule ought to be of itself a sufficient answer to complainant's proposition."

National Co. v. Automatic Co., *supra,* was decided under the Act as amended in 1900. A perpetual injunction was granted after final hearing and complainant appealed from that part of the decree which refused an injunction. On the authority of *Westinghouse Co.* v. *Christenson Co., supra,* the court refused to entertain this appeal.

Western Electric Co. v. Abbott, *supra,* was decided after the amendment of 1900. The decree granted an injunction as to two of the claims and refused an injunction as to a third claim. In this case it was contended, as does the petitioner here, that as the decree finally disposed of the first claim of the patent, an appeal would lie independently of the statute. The court overruled this contention, saying, on page 957:

"But as that part of the decree did not finally dispose of the whole case, which was retained for the purpose of an accounting upon the claims held valid, the right to appeal from the dismissal of the bill as to the first claim would be suspended until the final decree, when that action and any other which might be prejudicial, could be brought up on one appeal. The other course would sanction the bringing up of a case 'piecemeal.' In thus holding we are in agreement with the opinion of the circuit court of appeals for the First circuit in *Marden* v. *Printing-Press Co.*, 15 C. C. A., 26, 33 U. S. App., 123, 67 Fed., 809."

Columbia Mfg. Co. v. Boyce, *supra,* holds that since the amendment of 1900 there can be no appeal from an interlocutory order refusing a preliminary injunction. This case deals with a preliminary injunction as distinguished from a perpetual injunction. It holds that the amendment of 1900 repealed the amendment of 1895.

Fry & Bruhn v. Carstens, *supra,* is likewise a case dealing with a preliminary injunction and the court held that no appeal lies from an interlocutory order refusing a preliminary injunction.

We thus see that the Circuit Courts of Appeal have been quite uniform in holding that where an interlocutory decree both grants and refuses an injunction, the review will be limited to that part which grants the injunction, and that neither an independent appeal nor a cross-appeal by complainant to review that part refusing the injunction will be entertained.

However, there is a recent decision by the Court of Appeals for the Seventh Circuit, which has interpreted *Smith* v. *Vulcan Works* as authorizing the consideration of the portion of the decree refusing the injunction under certain conditions, which conditions, however, do not exist in the cause at present before the court.

D.

Chicago Co. v. Miller Co., 133 Fed. Rep., 145, is the case in the Seventh Circuit. This case, however, differs from the present case in two vital particulars.

(1) In that case there was a *single* decree granting an injunction as to part of the claims and refusing an injunction as to the remainder; in this case there are *two* separate interlocutory decrees, the first granting an injunction and the second refusing an injunction; the second decree from which complainant appeals having been entered *after* defendant had perfected its appeal from the first decree which granted an injunction.

(2) In that case defendant, in perfecting its appeal from the single decree, brought up the *entire* record to the Court of Appeals, and *after* the entire record had been brought to the Court of Appeals, complainant took a cross-appeal; in the present case, but a part of the record would have been taken up by the defendant had the appeal by the complainant not been taken. The patent exhibits and the evidence relating to claims 6, 7 and 8, on which the injunction was refused by the second decree, were entirely different from those relating to claims 4 and 5, upon which an injunction was granted by the first decree, and would not have been included in the record had not complainant appealed and assisted in making up a *joint* record in accordance with the rules to cover both appeals.

As appears from paragraph (11), page 13 of the Return in this case, there is a rule of the Circuit Court that where an appeal is taken by both the complainant and the defendant, the parties may agree that one certification and one transcript of record may be made up, containing the papers and documents to be relied upon by both parties, the cost thereof to be borne equally by the parties in the first instance, and to be apportioned thereafter by the Circuit Court of Appeals. In accordance with this rule a joint record was made, as appears from paragraph (11), page 13 of the Return, which concludes as follows:

> "That a joint record in this cause was made up by the complainant and defendant after the two appeals had been allowed."

Complainant, therefore, in the present case could not prosecute a cross-appeal on the theory that the defendant had taken up the *entire* record, as was the case in *Chicago Co.* v. *Miller Co.*, because in the present case no record whatever had been taken to the Court of Appeals at the date complainant prosecuted its appeal, and, as a matter of fact, complainant's appeal was originally prosecuted on the theory that the second decree was final and would, therefore, support an independent appeal.

E.

But even though the facts in the present case were the same as those in *Chicago Co.* v. *Miller Co.*, it is submitted that that case is not based upon a proper interpretation of the law:

(1) Because *Chicago Co.* v. *Miller Co.* is contrary to the express language of the statute and the evident intent of Congress in enacting the same; and

(2) Because *Smith* v. *Vulcan Works* is not authority for the doctrine announced in *Chicago Co.* v. *Miller Co.*

(1)

Section 7 of the Judiciary Act of 1891, allowing appeals from interlocutory orders or decrees (Stat. 1889-91, Ch. 517, pa. 828), reads as follows:

> "Sec. 7. That where, upon a hearing in equity in a district

court, or in an existing circuit court, *an injunction shall be granted or continued by an interlocutory order or decree,* in a cause in which an appeal from a final decree may be taken under the provisions of this act to the Circuit Court of Appeals, *an appeal may be taken from such interlocutory order or decree granting or continuing such injunction* to the Circuit Court of Appeals: Provided, That the appeal must be taken within thirty days from the entry of such order or decree, and it shall take precedence in the appellate court; and the proceedings in other respects in the court below shall not be stayed unless otherwise ordered by that court during the pendency of such appeal."

It will be noted that this section as originally enacted in 1891 allows an appeal within thirty days from an interlocutory order or decree *granting* or *continuing* an injunction. It does not allow an appeal from an order or decree *refusing* an injunction.

While this law was in force a number of decisions, heretofore discussed, were rendered by the several Circuit Courts of Appeals, holding that, in an appeal from an interlocutory decree granting an injunction as to certain claims and refusing an injunction as to other claims, the review would be limited to that portion of the decree which *granted* the injunction and that neither an independent appeal nor a cross-appeal from that portion of the decree refusing the injunction would be considered.

With the practice thus established, Section 7 was, in 1895, amended by Chapter 96 of the Statutes of 1895, to enlarge the right of appeal. Section 7, as thus amended, reads as follows (Stat. 1893-95, page 666):

"That, where, upon a hearing in equity in a district court or a circuit court, *an injunction shall be granted, continued, refused, or dissolved by an interlocutory order or decree, or an application to dissolve an injunction shall be refused* in a case in which an appeal from a final decree may be taken under the provisions of this act to the Circuit Court of Appeals, *an appeal may be taken from such interlocutory order or decree, granting, continuing, refusing, dissolving or refusing to dissolve an injunction* to the Circuit Court of Appeals; provided, that the appeal must be taken within thirty days from the entry of such order or decree, and it shall take precedence in the appellate court; and the proceedings in other respects in the court below

shall not be stayed unless otherwise ordered by that court during the pendency of such appeal; and provided further, that the court below may, in its discretion, require as a condition of the appeal, an additional injunction bond."

Section 7, as thus amended in 1895, provided for an appeal from a decree *refusing* or *dissolving* an injunction. Accordingly, complainant could appeal from a decree which alone refused an injunction or could prosecute an independent appeal or a cross-appeal from that portion of a decree refusing an injunction where the decree both granted and refused an injunction. This amendment altered the practice established by the courts by the decisions heretofore discussed.

In 1900 Section 7 was again amended by Chapter 803 of the Statutes of 1900 (Stat. 1899-01, p. 600), to read as follows:

> "Sec. 7. That where, upon a hearing in equity, in a district court or in a circuit court, or by a judge thereof in vacation, *an injunction shall be granted or continued* or a receiver appointed, *by an interlocutory order or decree*, in a cause in which an appeal from a final decree may be taken under the provisions of this Act to the Circuit Court of Appeals, *an appeal may be taken from such interlocutory order or decree granting or continuing such injunction*, or appointing such receiver to the Circuit Court of Appeals: Provided, that the appeal must be taken within thirty days from the entry of such order or decree, and it shall take precedence in the Appellate Court; and the proceedings in other respects in the court below shall not be stayed, unless otherwise ordered by that court, or by the appellate court or a judge thereof, during the pendency of such appeal: Provided further, that the court below may in its discretion require as a condition of the appeal, an additional bond."

It will be noted that the amendment of 1900 makes Section 7, so far as injunctions are concerned, practically the same as in the original Act of 1891. The amendment of 1900 grants appeal from an interlocutory order or decree appointing a receiver, but this alteration does not concern the present inquiry. So far as the question of injunction is concerned, the amendment of 1900 took away the right to appeal from an interlocutory order or decree *refusing* or *dissolving* an injunction. Accordingly, after the amendment of

1900 the decisions of the courts interpreting Section 7 of the original Act of 1891, became again effective. An independent appeal from an interlocutory order or decree, which alone refuses an injunction, cannot be entertained, nor can an independent appeal or a cross-appeal be prosecuted from that portion of an interlocutory decree or order refusing an injunction where the decree both grants and refuses an injunction. The decisions of the Courts of Appeals after 1900 are, with the exception of *Chicago Co.* v. *Miller Co.*, in conformity with this view.

The history of Section 7 and the amendments thereto, thus clearly establishes the intent of Congress to deny the right of prosecuting an appeal from a decree, or that portion of a decree, refusing an injunction, until after the entry of the final decree. The only review which is permitted prior to the entry of the final decree is when an injunction is granted, in which case irreparable injury might follow if a review was not permitted until after the entry of the final decree. In the case of the refusal of an injunction, however, no summary action results, and accordingly, the right of review must await the entry of the final decree.

(2)

We have heretofore directed attention to the fact that *Smith* v. *Vulcan Works* does not decide the precise point here involved. In that case an interlocutory decree was entered, which sustained *all* of the claims in suit and granted an injunction with respect thereto, so that no part of the decree *refused an injunction*. The injunction thus covered the entire case.

This court held that upon an appeal from such a decree, which granted an injunction (but which *did not refuse* an injunction), the *whole* decree was before the appellate tribunal for review, and that tribunal could investigate not only the propriety of granting the injunction, but could also determine the merits of the controversy and pass upon the questions of patentability and infringement, and had the power to dismiss the bill of complaint for want of equity should it find against the complainant upon the merits.

Smith v. *Vulcan Works* therefore does not decide that where an interlocutory decree both grants and refuses an injunction and the defendant prosecutes an appeal from that part of the decree which grants the injunction, the complainant can prosecute a cross-appeal from *that part* which *refuses* an injunction. This is the proposition for which the petitioner herein contends.

Upon defendant's appeal from that part of an interlocutory decree, granting an injunction, *Smith* v. *Vulcan Works* is authority for the Court of Appeals to investigate, not only (1) the propriety of granting the injunction, but (2) the validity of the claims in suit, and (3) the question of infringement thereof. But *Smith* v. *Vulcan Works* is not direct authority for the contention that the Court of Appeals has the jurisdiction also to entertain a cross-appeal from that part of the interlocutory decree refusing an injunction as to a part of the claims in suit.

The only theory, therefore, upon which *Smith* v. *Vulcan Works* may be held to be applicable to the present controversy is that certain general language employed in that case is applicable to the circumstances of the present controversy. This language reads as follows (page 524):

> "The provision of section 7 of the act of 1891, that where 'upon a hearing in equity' in a Circuit Court 'an injunction shall be granted or continued by an interlocutory order or decree,' in a cause in which an appeal from a final decree might be taken to the Circuit Court of Appeals, 'an appeal may be taken from such interlocutory order or decree granting or continuing such injunction' to that court, authorizes, according to its grammatical construction and natural meaning, an appeal to be taken from the whole of such interlocutory order or decree, and not from that part of it only which grants or continues an injunction."

The decision thus states that an appeal may be taken

> "from the whole of such interlocutory order or decree, and not from that part of it only which grants or continues an injunction."

In the case then before the court, the decree dealt only with the grant of an injunction, and consequently the *whole* decree concerned itself

with the grant of an injunction, and did not in any part concern itself with the *refusal* of an injunction. One part of the decree dealt with the finding of validity of the claims in suit, another part with the finding of infringement of the claims in suit, and another part with the issuance of an injunction. The question presented was whether the appellate tribunal must confine itself to that part which dealt with the issuance of the injunction or could also consider those parts which dealt with the questions of validity and infringement and upon which ultimately the propriety of issuing the injunction must rest. By the language above quoted, the court held that the *whole* of the decree, that is, the decree in its three parts, could be reviewed by the appellate tribunal.

The petitioner herein would expand this language beyond the facts then before the court, and contends that this general language authorizes the appellate tribunal to step *beyond the subject-matter concerned with the injunction* and to review by complainant's cross-appeal, parts of an interlocutory decree *dealing with the refusal of an injunction,* where it appears that the same interlocutory decree deals with both the granting and the refusal of an injunction.

One of the leading cases in the Courts of Appeals before *Smith* v. *Vulcan Works* was decided by this court, was

Richmond v. Atwood, 52 Fed. Rep., 10, decided by the Circuit Court of Appeals for the First Circuit. In this case an interlocutory decree was entered finding validity and infringement of the patent in suit and granting an injunction. The question arose as to whether the appellate tribunal on an appeal under Section 7 of the Act of 1891, could consider the merits and pass upon the questions of validity and infringement, or was confined to the mere question of the propriety of granting the injunction, this being the precise question which was presented in *Smith* v. *Vulcan Works.* After exhaustively reviewing the authorities the law was announced in *Richmond* v. *Atwood,* that the appellate tribunal could pass upon the merits, and this doctrine was thereafter approved and established in *Smith* v. *Vulcan Works.*

In **Marden v. Campbell Co.,** 67 Fed., 809, an interlocutory decree was entered both granting and refusing an injunction The defendant prosecuted an appeal under Section 7 of the Act of 1891, from that part of the interlocutory decree granting the injunction, and complainant prosecuted a cross-appeal from that part of the interlocutory decree refusing the injunction. Upon motion of defendant to dismiss complainant's cross-appeal, the identical question was presented to the Circuit Court of Appeals of the First Circuit that is presented by the petitioner herein. In *Marden* v. *Campbell Co.,* the decision in *Richmond* v. *Atwood* was relied upon, just as the petitioner herein relies upon *Smith* v. *Vulcan Works.*

In *Richmond* v. *Atwood* the court used general language in dealing with the facts in that case, which was susceptible of a broader interpretation than was there evidently intended, just as is the case in the present instance, where the petitioner endeavors to rely upon general language used by this court in *Smith* v. *Vulcan Works.*

The Court of Appeals for the First Circuit, in *Marden* v. *Campbell Co.,* analyzes this previous decision in *Richmond* v. *Atwood,* and specifically directs attention to the fact that the two cases are radically different in that in *Richmond* v. *Atwood* the interlocutory decree by the granting of the injunction disposed of the entire controversy, while in *Marden* v. *Campbell Co.*, the granting of the injunction was but a *part* of the subject-matter covered by the interlocutory decree, which also *refused* an injunction. The court held that, in view of *Richmond* v. *Atwood,* the appellate tribunal could consider all of the subject-matter of the interlocutory decree dealing directly or indirectly with the injunction, and could therefore pass upon the merits as to validity and infringement, but that this did not authorize the appellate tribunal to *reach out for parts of the decree not covered by the injunction,* or to permit the complainant to bring up such matters by cross-appeal. The court in *Marden* v. *Campbell Co.* said, in referring to *Richmond* v. *Atwood* (page 814):

"It is apparent, however, from the closing sentences in *Rich-*

mond v. *Atwood*, that the rule is one of equitable convenience, to be applied when the *full* record is brought before us on account of an appeal against an injunction granted by an interlocutory decree after a full hearing. There is no indication in *Richmond* v. *Atwood* of any disposition *to go further than this*, or to permit *other parts of a decree* to be brought up by cross appeals, or appeals of the complainant below, for the purpose of being heard as on an appeal from a final decree." (Italics ours.)

The court thus clearly points out that the doctrine announced in *Richmond* v. *Atwood*, where the granting of the injunction covered the whole case, is not to be construed as authorizing the complainant to prosecute a cross-appeal or an appeal from *that part* of an interlocutory decree not dealing with an injunction.

The court then directs attention to the fact that in *Richmond* v. *Atwood* the injunction covers the entire case, and for that reason the disposal of the entire subject-matter by the appellate tribunal cannot be objectionable to the court or the parties. The court says (page 814):

> "Under the circumstances of *Richmond* v. *Atwood*, the injunction covers the entire case, and thus an appeal from the injunction brings up the whole decree, and necessarily the whole record, so that the court is required, for the mere purpose of adjudicating, touching the injunction, to examine on appeal the entire case; and so no detriment to the court or the parties can come by its thereupon disposing of the merits, and entering orders to the circuit court analogous to those entered upon an appeal from a final decree."

The court then points out that the passing upon the whole decree in a case where the injunction covers the entire case, is very different from reaching out for matters not covered by the injunction, in a case where the decree relates to other matters besides the grant of an injunction. The court says (page 814):

> "This, however, is a very different thing from reaching out for parts of the record, and of the decree below, not covered by the injunction order. While it should not be said that *Richmond* v. *Atwood*, and the rules determined by it, are limited to cases in the precise condition of *Richmond* v. *Atwood* itself,

yet it is entirely clear, for the reasons which we have stated, that it was not therein intended to embrace within the scope of the conclusions in that case the disposition, as on its merits, of the entirety of an interlocutory decree of the character of the one at bar, which the injunction touches *only in part.*"

As above noted, the petitioner herein would interpret the general language used by the court in *Smith* v. *Vulcan Works* to permit a cross-appeal from that part of the interlocutory decree refusing an injunction, just as the complainant in *Marden* v. *Campbell Co.* would have interpreted the general language employed by the court in *Richmond* v. *Atwood* in support of the same proposition, and just as in *Marden* v. *Campbell Co.*, the fallacy of such contention was clearly pointed out, so in the present case for the same reasons *Smith* v. *Vulcan Works* cannot, in view of the different circumstances there presented, be authority for the position of the petitioner herein.

This court cites *Morden* v. *Campbell Co.*, approvingly in *Smith* v. *Vulcan Works.*

The foregoing discussion assumes that the granting and the refusing of the injunction are embraced in a *single* decree, for unless they are so embraced, even the general language employed in *Smith* v. *Vulcan Works* is not applicable. We have heretofore directed attention to the fact that in the present case before this court, there is not a *single* decree, both granting and refusing an injunction, but that, on the contrary, there were *two* separate and distinct interlocutory decrees, one granting an injunction and containing no finding adverse to complainant, and the other refusing an injunction. Defendant perfected its appeal from the first decree before the second decree was entered and before complainant prosecuted its appeal from the second decree. Accordingly, complainant's appeal cannot be considered in any sense a cross-appeal, but must stand or fall as an independent appeal. And, inasmuch as an appeal from a decree refusing an injunction cannot be taken under Section 7, but must be taken under Section 6, of the Act of 1891, the appeal from the second decree cannot stand, unless

it appears that the second decree was a *final* decree. We have heretofore shown conclusively, as we believe, that the second decree was not a final decree, because it did not dispose of the entire subject-matter in litigation.

It is respectfully submitted, in view of the above, that the petition for the writ of mandamus should be denied and the rule discharged,

(1) For the reason that the issuance of the writ of mandamus is not the proper practice under the circumstances of this case,

(*a*) because the petitioner has an adequate remedy by an appeal after the entry of a final decree,

(*b*) because the Supreme Court of the United States does not have appellate jurisdiction of this cause and cannot therefore grant the writ of mandamus in aid of these proceedings, and

(*c*) because the order of the Court of Appeals dismissing complainant's so-called cross-appeal was an interlocutory order entered in the progress of a cause of which the Court of Appeals has accepted jurisdiction and was not of that final and conclusive character which put the entire subject-matter in litigation out of court; and

(2) For the reason that the Circuit Court of Appeals was without jurisdiction to entertain complainant's appeal, or so-called cross-appeal,

(*a*) because the second interlocutory decree from which complainant appealed was not a final decree, and therefore an appeal does not lie under Section 6 of the Act of 1891,

(*b*) because the first interlocutory decree from which defendant appealed was wholly in favor of complainant and complainant could not therefore prosecute a cross-appeal therefrom under Section 7 of the Act of 1891,

(*c*) because the second interlocutory decree from which complainant appealed was entered after defendant had perfected its appeal from the first interlocutory decree and therefore complainant cannot base a cross-appeal upon the second interlocutory decree, and

(*d*) because even though the two decrees should be considered in effect a single decree (which they cannot under the circum-

stances), Section 7 of the Act of 1891 does not authorize an appeal from that portion of an interlocutory decree refusing an injunction.

Respectfully submitted,

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JOHN RIDOUT,
Of Counsel.

Supreme Court of the United States.

No. 17, Original.—October Term, 1905.

Ex parte National Enameling and Stamping Company and Lalance & Grosjean Manufacturing Company, Petitioners. } Petition for Writ of Mandamus.

[March 19, 1906.]

In March, 1903, the petitioners filed their bill in the Circuit Court of the United States for the Southern District of New York against the New England Enameling Company, to restrain the further infringement by that company of letters patent of the United States, No. 527,361, for improvements in enameling metal ware, and to recover damages for past infringement. After answer and proofs the case came on for hearing, and on July 8, 1905, a decree was entered, reciting that nine of the twelve claims in the patent were good and valid, that three were invalid and void by reason of the fact that the patentee was not the original or first inventor or discoverer, that five of the nine valid claims had been infringed by the defendant, but the remaining four had not been. As to the claims held invalid and those found to have been not infringed, it was ordered that the bill of complaint be dismissed. As to the remaining five claims, those held to be infringed, it was ordered that the plaintiffs recover the gains, profits, savings and advantages which the defendant had derived by reason of the infringement, and that the case be referred to a master to report the amount thereof, and also that an injunction issue against further infringement. On August 1, 1905, the defendant appealed from said decree to the Court of Appeals and filed its assignment of errors. On August 8 the plaintiffs also appealed to the Circuit Court of Appeals and assigned as errors the rulings in the decree adverse to them. On January 3, 1906, this cross appeal of the plaintiffs was dismissed by the Court of Appeals, on the ground that it had no jurisdiction thereof. Thereupon the plaintiffs filed in this court this petition for a writ of mandamus commanding the judges of the Circuit Court of Appeals to take jurisdiction of said cross appeal, and to dispose of it simultaneously with the appeal of the defendant.

Mr. Justice Brewer delivered the opinion of the Court.

The decree entered by the Circuit Court was interlocutory and not final. *Barnard* v. *Gibson*, 7 How. 650; *Humiston* v. *Stainthorp*, 2 Wall. 106,

and cases cited in note; *Estey* v. *Burdett*, 109 U. S. 633, 637; *McGourkey* v. *Toledo & Ohio Railway Company*, 146 U. S. 536 (in this case is a full discussion of the differences between an interlocutory and a final decree;) *Hohorst* v. *Hamburg-American Packet Company*, 148 U. S. 262; *Smith* v. *Vulcan Iron Works*, 165 U. S. 518.

Plaintiffs brought one suit upon a single patent. The findings of the Circuit Court that three of the twelve claims were invalid and that the remaining nine were valid, but that four of them had not been infringed by the defendant, did not break this one suit into twelve. They were a guide to the master in his ascertainment of the damages and indicated the scope of the final decree.

In the Federal courts no appeal can, as a general rule, be taken, except from a final decree. As said by Mr. Chief Justice Taney in *Forgay* v. *Conrad*, 6 How. 201, 205:

"In this respect the practice of the United States chancery courts differs from the English practice. For appeals to the House of Lords may be taken from an interlocutory order of the Chancellor, which decides a right of property in dispute. . . . But the case is otherwise in the courts of the United States, where the right of appeal is by law limited to final decrees." See also *McLish* v. *Roff*, 141 U. S. 661, 665.

In the latter case this was held persuasive against extending the right of review given by section 5 of the Circuit Court of Appeals act of March 3, 1891, (26 U. S. Stat. 826,) to other cases than those in which there was a final judgment or decree, although the word "final" is omitted in some of the clauses of the section.

By section 7 of that act, however, an appeal was provided from certain interlocutory orders or decrees. That section has been twice amended. (28 U. S. Stat. 666; 31 U. S. Stat. 660.) As it now stands it reads:

"SEC. 7. That where, upon a hearing in equity in a District Court or in a Circuit Court, or by a judge thereof in vacation, an injunction shall be granted or continued or a receiver appointed, by an interlocutory order or decree, in a cause in which an appeal from a final decree may be taken under the provisions of this act to the Circuit Court of Appeals, an appeal may be taken from such interlocutory order or decree granting or continuing such injunction or appointing such receiver to the Circuit Court of Appeals: *Provided*, That the appeal must be taken within thirty days from the entry of such order or decree, and it shall take precedence in the appellate court; and the proceedings in other respects in the court below shall not be stayed, unless otherwise ordered by that court, or by the appellate court or a judge thereof, during the pendency of such appeal: *Provided, further*, That the court below may in its discretion require as a condition of the appeal an additional bond."

It will be noticed that the appeal is allowed from an interlocutory order or decree granting or continuing an injunction, that it must be taken within thirty days, that it is given precedence in the appellate court,

that the other proceedings in the lower court are not to be stayed, and that the lower court may require an additional bond. Obviously that which is contemplated is a review of the interlocutory order, and of that only. It was not intended that the cause as a whole should be transferred to the appellate court prior to the final decree. The case, except for the hearing on the appeal from the interlocutory order, is to proceed in the lower court as though no such appeal had been taken, unless otherwise specially ordered. It may be true, as alleged by petitioners, that "it is of the utmost importance to all of the parties in said cause that there shall be the speediest possible adjudication by the United States Circuit Court of Appeals as to the validity of all of the claims of the aforesaid letters patent which are the subject matter thereof." But it was not intended by this section to give to patent or other cases in which interlocutory decrees or orders were made any precedence. It is generally true that it is of importance to litigants that their cases be disposed of promptly, but other cases have the same right to early hearing. And the purpose of Congress in this legislation was that there be an immediate review of the interlocutory proceedings and not an advancement generally over other litigation.

Petitioners rely mainly on *Smith* v. *Vulcan Iron Works*, 165 U. S. 518. In that case it was held that when an appeal is taken from an interlocutory order granting or continuing an injunction, the whole of the order is taken up, and the appellate court may (if upon an examination of the record as thus presented it is satisfied that the bill is entirely destitute of equity) direct a dismissal, and is not limited to a mere reversal of the order granting or continuing the injunction. Take an ordinary patent case. If an injunction is granted by an interlocutory order and the order is taken on appeal to the Circuit Court of Appeals, and that court is of opinion that the patent is on its face absolutely void, it would be a waste of time and an unnecessary continuance of litigation to simply enter an order setting aside the injunction and remanding the case for further proceedings. The direct and obvious way is to order a dismissal of the case, and thus end the litigation. And such is the scope of the opinion in that case. After noticing the general rule that appeals will not lie until after final decree, and that an order or decree in a patent case granting an injunction and sending the cause to a master for accounting is interlocutory only, and therefore not reviewable on appeal before the final decree in the case, it referred to the provision of section 7, and said (p. 525):

"The manifest intent of this provision, read in the light of the previous practice in the courts of the United States, contrasted with the practice in courts of equity of the highest authority elsewhere, appears to this court to have been, not only to permit the defendant to obtain immediate relief from an injunction, the continuance of which throughout the

progress of the cause might seriously affect his interests; but also to save both parties from the expense of further litigation, should the appellate court be of opinion that the plaintiff was not entitled to an injunction because his bill had no equity to support it."

But nowhere in the opinion is it intimated that the plaintiff was entitled to take any cross appeal or to obtain a final decree in the appellate court. This view of the scope of section 7 was reaffirmed in *Mast, Foos & Co.* v. *Stover Manufacturing Company*, 177 U. S. 485, 494, 495.

It is suggested that, as to the claims held to be invalid and those held to be valid but not infringed, the bill was dismissed; that thus, in fact, a final decree was entered which entitled the plaintiff to an appeal. *Forgay* v. *Conrad*, *supra*, and *Hill* v. *Chicago & Evanston Railroad Company*, 140 U. S. 52, are cited as authorities. In both these cases there were several defendants and the decrees were adjudged final only in respect to certain of the defendants. In the first the Circuit Court passed a decree declaring sundry deeds to be fraudulent and void and directing the lands and slaves therein mentioned to be delivered up to the complainant, and also directing one of the defendants named in the decree to pay him $11,000, and "that the complainant do have execution for the several matters aforesaid in conformity with law and the practice described by the Supreme Court of the United States." The court refused to dismiss the appeal, holding that, while the decree was not final in the strict technical sense of the term, yet in view of the effect of the orders entered and the fact that unless review was granted at once there might be irreparable injury, the decree must be regarded as final to that extent. At the same time it criticised the terms of the decree, said that the final orders should have been delayed until the master's report was received, and added, after its comments upon the procedure below, (p. 206):

"These remarks are not made for the purpose of censuring the learned judge by whom this decree was pronounced, but in order to call the attention of the Circuit Courts to an inconvenient practice into which some of them have sometimes fallen, and which is regarded by this court as altogether inconsistent with the objects and policy of the acts of Congress in relation to appeals, and at the same time needlessly burdensome and expensive to the parties concerned, and calculated, by successive appeals, to produce great and unreasonable delays in suits in chancery. For it may well happen that, when the accounts are taken and reported by the master, this case may again come here upon exceptions to his report, allowed or disallowed by the Circuit Court, and thus two appeals made necessary, when the matters in dispute could more conveniently and speedily, and with less expense have been decided in one."

In the subsequent case of *Beebe* v. *Russell*, 19 How. 283, in which the rule in reference to the finality of decrees was further considered, it was said, in explanation of the decision in the *Forgay case*, (p. 287):

"In *Forgay's case*, it [the question] was made upon the decree given by the court below, and it was adjudged by this court to be final to give this court jurisdiction of it. But it was so, upon the ground that the whole merits of the controversy between the parties had been determined, *that execution had been awarded*, and that the case had been referred to the master merely for the purpose of adjusting the accounts. The fact is, *the order of the court in that case for referring it to a master was peculiar*, making it doubtful, if it could in any way control or qualify the antecedent decree of the court upon the whole merits of the controversy, or modify it in any way, *except upon a petition for a rehearing*."

In *Hill* v. *Chicago & Evanston Railroad Company*, *supra*, there had been an order of dismissal in favor of some of defendants, together with a reference to a master of a separable controversy between the plaintiff and other parties, and the court observed (p. 54):

"But there was no adjudication as to the payment of the amount to be ascertained by the master; that remained unsettled. It was, however, a severable matter from the other subjects of controversy and did not affect their determination. The fact that it was not disposed of did not change the finality of the decree as to the defendants against whom the bill was dismissed; that amount, or to whom made payable, did not concern them. They were no longer parties to the suit for any purpose. The appeal from the subsequent decree did not reinstate them. All the merits of the controversy pending between them and the complainant were disposed of, and could not be again reopened, except on appeal from that decree. As to the other parties, it remained to ascertain the amount of one item and to determine as to its payment."

But as held in *Hohorst* v. *Hamburg-American Packet Company*, *supra*, that rule does not apply to cases where the liability of the defendant is alleged to be joint; and, therefore, cannot to a case in which there is but a single defendant.

The rule is discharged, and the application for a writ of mandamus is denied.

No. 18, Original.

Ex parte Automatic Switch Company of Baltimore City, Petitioner. } Petition for Writ of Mandamus.

[March 19, 1906.]

Mr. Justice BREWER delivered the opinion of the Court.

This case, though differing in its facts somewhat from the one immediately preceding, presents the same question, and the same order will be entered.